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VALUING “DOMESTIC SELF-DETERMINATION” IN INTERNATIONAL INTELLECTUAL PROPERTY JURISPRUDENCE

GRAEME W. AUSTIN*

INTRODUCTION

That intellectual property rights are “strictly territorial”¹ once seemed a relatively straightforward idea. Unlicensed sale of patented products in both Germany and the United Kingdom gave rise to distinct causes of action in German and English courts.² Canadian trademark law governed distribution of trademarked products in Canada, even where infringement litigation was initiated in a US court by a US plaintiff.³ Infringement of an architectural copyright by unauthorized construction of a building in Rotterdam implicated Dutch copyright law, even where plaintiff and defendant were English residents and the original plans were drawn in London.⁴ Worldwide distribution of a videocassette that reproduced a musical work

* Professor of Law, James E. Rogers College of Law, The University of Arizona. I am grateful for the insightful comments of Graeme Dinwoodie, Paul Myburgh and Bill Atkin on earlier drafts, and for the excellent research assistance provided by Susan Myers. I am also indebted to Maureen Garmon of the University of Arizona Law Library for her assistance in locating sources referred to in this Article and to Eric Priest and Adrienne Zahner of the *Chicago-Kent Law Review* for their careful editing and helpful suggestions. This Article began as a paper delivered on October 18, 2001 at the Chicago-Kent College of Law conference, “Constructing International Intellectual Property Law: The Role of National Courts,” where I was asked to present a paper discussing the continuing relevance of the territoriality principle for international intellectual property law. © 2001, Graeme W. Austin.

1. *Abkco Music & Records, Inc., v. Music Collection Int’l Ltd.* [1995] R.P.C. 657, 660 (Hoffmann, L.J.).

2. *Plastus Kreativ AB v. Minn. Mining and Mfg. Co.*, [1995] R.P.C. 438, 446 (holding that English Court does not have subject matter jurisdiction over infringement of German and French patents).

3. *Vanity Fair Mills, Inc. v. T. Eaton Co.*, 234 F.2d 633 (2d Cir. 1956) (holding that Canadian trademark law, not the Lanham Act, applies to infringement of trademark rights in Canada).

4. *Pearce v. Ove Arup P’ship*, [1999] 1 All E.R. 769 (C.A.). The jurisdictional issues in *Pearce* were adjudicated under the Convention on Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters, Sept. 27, 1968, 1978 O.J. (L) 304 [hereinafter Brussels Convention]. However, the opinion was fully reasoned on the common law principles applying to the issue of jurisdiction.

without a license might implicate the copyright laws of all of the countries in which the videocassette was distributed.⁵

As many commentators have pointed out, the territoriality of intellectual property laws is not as straightforward in the “internationally networked” environment.⁶ When a party resident in Country A loads a copyrighted work, a trademark, the data comprising a trade secret, or the code underlying a business method patent onto a website in Country B without an appropriate license, and the website is accessible to web surfers all over the world, localization of legally cognizable infringements of intellectual property rights is fraught with problems.⁷ And where a multiplicity of potential laws might apply, the territoriality principle comes under considerable pressure to adapt.⁸ Though the “upward harmonization”⁹ agenda in the public international law of intellectual property may theoretically be consistent with the territoriality premise,¹⁰ one *effect* of the development and promotion of standardized international norms¹¹ and their adop-

5. *Boosey & Hawkes Music Publishers v. Walt Disney Co.*, 145 F.3d 481 (2d Cir. 1998) (noting that court should apply the copyright laws of at least eighteen foreign countries in a dispute over a videocassette distributed in as many countries).

6. See, e.g., Paul Edward Geller, *Intellectual Property in the Global Marketplace: Impact of TRIPS Dispute Settlements?*, 29 INT'L LAW 99, 103 (1995) [hereinafter Geller, *TRIPS Dispute Settlement*]; Paul Edward Geller, *The Universal Electronic Archive: Issues in International Copyright*, 25 INT'L REV. INDUS. PROP. & COPYRIGHT L. 54 (1994) [hereinafter Geller, *Universal Electronic Archive*]; Jane C. Ginsburg, *The Cyberian Captivity of Copyright: Territoriality and Authors' Rights in a Networked World*, 15 SANTA CLARA COMPUTER & HIGH TECH. L.J. 347 (1999) [hereinafter Ginsburg, *Cyberian Captivity*]; Raymond T. Nimmer, *Licensing on the Global Information Infrastructure: Disharmony in Cyberspace*, 16 NW. J. INT'L L. & BUS. 224 (1995).

7. Henry H. Perritt, Jr., *Economic and Other Barriers to Electronic Commerce*, 21 U. PA. J. INT'L ECON. L. 563, 570–71 (2000) (discussing difficulty of localizing causes of action arising from Internet conduct); Geller, *TRIPS Dispute Settlement*, *supra* note 6, at 101–03 (discussing difficulty of localizing intellectual property infringements).

8. See, e.g., Andreas P. Reindl, *Choosing Law in Cyberspace: Copyright Conflicts on Global Networks*, 19 MICH. J. INT'L L. 799, 808 (1998) (noting that, based on a territorial perspective of transnational infringement, a “multiplicity” of foreign laws would apply to an infringing work that could be accessed in various jurisdictions).

9. See generally Keith Aoki, *Considering Multiple and Overlapping Sovereignities: Liberalism, Libertarianism, National Sovereignty, “Global” Intellectual Property, and the Internet*, 5 IND. J. GLOBAL LEGAL STUD. 443, 461 (1998) (discussing the “upward harmonization” agenda in international intellectual property relations).

10. Curtis A. Bradley, *US Territorial Intellectual Property Rights in an Age of Globalism*, 37 VA. J. INT'L L. 505, 549 (1997) (suggesting that the perceived need for uniformity between domestic intellectual property regimes arises because of the principle that domestic intellectual property laws do not have extraterritorial effect).

11. See, e.g., Berne Convention for the Protection of Literary and Artistic Works, July 24, 1971, 1161 U.N.T.S. 3 [hereinafter Berne Convention]; Agreement on Trade-Related Aspects of Intellectual Property Rights, Including Trade in Counterfeit Goods, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, [hereinafter WTO Agreement], Annex 1C, LEGAL INSTRUMENT—RESULTS OF THE URUGUAY ROUND vol. 31, 33 I.L.M. 81 (1994)

tion into domestic intellectual property law systems will inevitably be the diminishment in the role of domestic policy choices in the intellectual property law field. As a result, the traditional image of intellectual property laws as providing bundles of national, territorially confined rights may be becoming increasingly misleading.¹²

In the light of these developments, does the territoriality principle have any continued viability? Some commentators are doubtful, suggesting that the territoriality principle is now difficult to accommodate with the internationalization of intellectual property in the global environment.¹³ The contested character of the territoriality premise is of course an aspect of a broader set of issues arising out of the unbundling of the exclusive territoriality associated with the nation state in the globalized economy.¹⁴ In the intellectual property context, this point has perhaps been put at its highest by leading English intellectual property jurist Sir Robin Jacob. Extrapolating from the European experience, Sir Robin prophesizes that "[a]s time goes on, . . . the world will realize that at least for intellectual property the days of the nation-state are over."¹⁵ There are certainly important

[hereinafter TRIPs]; Paris Convention for the Protection of Industrial Property, Sept. 28, 1979, available at <http://www.wipo.int/clea/docs/en/wo/wo020en.htm> [hereinafter Paris Convention]; Madrid Agreement Concerning the International Registration of Marks, Sept. 28, 1979; Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, June 27, 1989, 3 B.T.S. 1997; World Intellectual Property Organization Copyright Treaty, Dec. 20, 1996, 36 I.L.M. 65 [hereinafter WIPO Copyright Treaty]; World Intellectual Property Organization Performances and Phonograms Treaty, Dec. 20, 1996, 36 I.L.M. 76; World Intellectual Property Organization Patent Law Treaty, June 1, 2000, 39 I.L.M. 1047; Directive 96/9/EC of the European Parliament and of the Council of 11 March 1996 on the Legal Protection of Databases, O.J. (L 77/20) [hereinafter Database Directive]; First Council Directive 89/104/EEC of 21 December 1988 to Approximate the Laws of the Member States Relating to Trade Marks, 1989 O.J. (L 40) 1; Council Directive 87/54/EEC of 16 December 1986 on the Legal Protection of Topographies of Semiconductor Products, 1987 O.J. (L 24) 36; Council Directive 2000/31/EC on Certain Legal Aspects of Information Society Services, in Particular, Electronic Commerce, in the Internal Market, 2000 O.J. (L 178); International Convention for the Protection of New Varieties of Plants, Mar. 19, 1991, available at <http://www.upov.int/eng/convntns/1991/pdf/act1991.pdf>.

12. See Jane C. Ginsburg, *International Copyright: From a "Bundle" of National Copyright Laws to a Supranational Code?*, 47 J. COPYRIGHT SOC'Y U.S.A. 265, 266 (2000) [hereinafter Ginsburg, *International Copyright*].

13. See Ginsburg, *Cyberian Captivity*, *supra* note 6, at 348–49 (questioning whether, in the copyright context, the globalization of methods of production and dissemination of copyright works means that copyright laws should or can remain tethered to the principle of territoriality); Geller, *Universal Electronic Archive*, *supra* note 6, at 55–56 (arguing that it is no longer appropriate to localize either works or their infringement within particular territories).

14. See, e.g., Saskia Sassen, *Toward a Feminist Analytics of the Global Economy*, 4 IND. J. GLOBAL LEGAL STUD. 7, 9 (1996); Daniel W. Drezner, *On the Balance Between International Law and Democratic Sovereignty*, 2 CHI. J. INT'L L. 321, 332–34 (2001) (discussing the role of the United States in challenges to domestic sovereignty of other nations).

15. Hon. Mr. Justice Jacob, *International Intellectual Property Litigation in the Next*

claims to be made for the efficiency gains that might follow from achieving standardized, supranational intellectual property laws.¹⁶ In some contexts, particularly for copyright law, efficiency gains may lead to more productive licensing of protected material:¹⁷ a strong case can be made that efficient, frictionless dissemination of copyright works is consistent with the promotion of the progress of knowledge.¹⁸

Notwithstanding projections such as this, it would be inappropriate, I believe, to assume (or even hope) that we are partway through a grand narrative that has the demise of territoriality and the achievement of standardized, supranational intellectual property laws as its inevitable dénouement.¹⁹ As I have suggested elsewhere, the benefits of supranational standards need to be balanced against the claims that can be made for the ability of domestic nations to do some things differently in the intellectual property context, as their individual circumstances might require.²⁰ At the same time, assertions of

Millennium, 32 CASE W. RES. J. INT'L L. 507, 516 (2000).

16. These are most likely to be relevant when determining the law relating to ownership and transfer. For detailed analysis of this question in the copyright context, see Jane C. Ginsburg, *The Private International Law of Copyright in an Era of Technological Change*, in 273 RECUEIL DES COURS 239, 363-74 (Hague Acad. of Int'l Law ed., 1998).

17. See generally Nimmer, *supra* note 6. Not all aspects of copyright's purposes are necessarily served by policies that promote frictionless licensing of copyright works. For instance, some of the author-focused rights associated with moral rights systems, such as the right to maintain the integrity of a work following transfer of economic rights, may "clog" the dissemination of copyright works in particular formats to which authors might object. See André Françon, *Protection of Artists' Moral Rights and the Internet*, in PERSPECTIVES ON INTELLECTUAL PROPERTY SERIES 75 (Frédéric Pollaud-Dulian ed., 1999).

18. The classic statement on economic efficiency justifications for intellectual property systems is Edmund Kitch, *The Nature and Function of the Patent System*, 20 J.L. & ECON. 265 (1977). This thesis has been developed in the copyright context by a number of authors. See, e.g., Sidney A. Rosenzweig, Comment, *Don't Put My Article Online!: Extending Copyright's New-Use Doctrine to the Electronic Publishing Media and Beyond*, 143 U. PA. L. REV. 899 (1995). These theories are fully discussed (and rigorously critiqued) in a recent work by Professor Cohen: Julie E. Cohen, Lochner in Cyberspace: *The New Economic Orthodoxy of "Rights Management"*, 97 MICH. L. REV. 462 (1998).

19. Professor Chen uses the metaphor of "evolution" to describe the progress of globalization. See Jim Chen, *Globalization and Its Losers*, 9 MINN. J. GLOBAL TRADE 157 (2000); Jim Chen, *Epiphytic Economics and the Politics of Place*, 10 MINN. J. GLOBAL TRADE 1 (2001).

20. Graeme W. Austin, *Social Policy Choices and Choice of Law for Copyright Infringement in Cyberspace*, 79 OR. L. REV. 575 (2000). Here, I am not questioning at the macro level the desirability of convergence of domestic intellectual property laws within the quasi-federal system of the European Union. For scholarship taking that approach, see generally Larry Catá Backer, *The Extra-National State: American Confederate Federalism and the European Union*, 7 COLUM. J. EUR. L. 173, 193-208 (2001). Leading English jurist Sir Hugh Laddie has recently described in detail the conflict between national systems of intellectual property rights and the policy of free movement of goods within the Economic Community, the latter being one of the key purposes of the Treaty of Rome, Treaty Establishing the European Economic Community, Mar. 25, 1957, 298 U.N.T.S. 11. Sir Hugh Laddie, *National I.P. Rights: A Moribund Anachronism in a Federal Europe?*, 23 E.I.P.R. 402 (2001). Numerous directives and

domestic self-determination cannot be allowed to thwart the development of international norms, particularly where the viability of domestic intellectual property systems depends, at least to some extent, on the networks of reciprocal obligations that the international system provides.²¹ As a descriptive matter, the principle of territoriality continues to shape commercial decision making, governmental policy agenda, and doctrinal development.²² In addition, a variety of normative claims in support of the continued relevance of territoriality can be based on ideas such as international comity,²³ the contestable propriety of unilateralist approaches to choice of law,²⁴ democratic accountability,²⁵ and the importance of intellectual property to domestic economies.²⁶

This Article explores claims that may be made for the continued viability of the territoriality principle that derive from concerns about the importance of domestic self-determination in domestic intellec-

decisions of the European Court of Justice are consistent with the principle that the free movement of goods takes priority as a matter of European policy over domestic control of intellectual property rights. *Id.* The text of Forth Recital of the EC Database Directive reflects this theme: "Whereas copyright protection for databases exists in varying forms in the Member States according to legislation or case-law, and whereas, if difference in legislation in the scope and conditions of protection remain between the Member States, such unharmonized intellectual property rights can have the effect of preventing the free movement of goods or services within the Community." Database Directive, *supra* note 11. Harmonization of intellectual property laws within the EU, where the EU institutions facilitate and govern the choice of European nations to achieve convergence in diverse legal, political, economic, and social fields, raises issues that are qualitatively very different from those arising in contexts in which these pre-existing political structures do not exist.

21. See generally Part II.C., *infra*; see also Graeme W. Austin, *Does the Copyright Clause Mandate Isolationism?*, 26 COLUM.-VLA J.L. & ARTS (forthcoming 2002) [hereinafter Austin, *Isolationism*].

22. Among the clearest indications of this in the Anglo-American context is the private international law jurisprudence emerging in English courts, from which it is clear that courts remain committed to the view that intellectual property rights are strictly territorial. See, e.g., *Abkco Music & Records, Inc. v. Music Collection Int'l Ltd.* [1995] R.P.C. 657; *Plastus Kreativ AB v. Minn. Mining & Mfg. Co.*, [1995] R.P.C. 438; *Chiron Corp. v. Organon Teknika Ltd.*, [1995] F.S.R. 325.

23. Bradley, *supra* note 10, at 513, 515.

24. See generally Mark P. Gibney, *The Extraterritorial Application of U.S. Law: The Pervasion of Democratic Governance, the Reversal of Institutional Roles, and the Imperative of Establishing Normative Principles*, 19 B.C. INT'L & COMP. L. REV. 297 (1996); David J. Santeusano, *Extraterritoriality and Secondary Boycotts: A Critical and Legal Analysis of United States Foreign Policy*, 21 SUFFOLK TRANSNAT'L L. REV. 367, 373-74 (1998).

25. See David R. Johnson & David G. Post, *The Rise of Law on the Global Network, in BORDERS IN CYBERSPACE* 3, 5-6 (Brian Kahin & Charles Nesson eds., 1997). This point is explored at length in *Integrating Intellectual Property Rights and Development Rights*, a report of the Commission on Intellectual Property Rights, London, September 2002, available at <http://www.iprcommission.org> [hereinafter *Integrating Intellectual Property Rights*].

26. Professor Aoki has written some of the most compelling recent work in this area. See Aoki, *supra* note 9.

tual property laws.²⁷ Here, “domestic self-determination” refers to the ability of individual nations to craft intellectual property laws to suit their own circumstances, circumstances that include both their domestic situations and their relationships with other nations. The concept of domestic self-determination is meant to capture the ability of individual nations to develop and test new intellectual property policies; it might also include the ability to calibrate the level and types of protection afforded to intellectual property proprietors in light of a nation’s specific circumstances, to craft new defenses and exemptions and expand existing ones, and to use intellectual property laws as vehicles for molding cultural and technical policies to suit domestic circumstances.

The processes and politics of globalization have distilled concerns about the inability of individual nations to pursue policies that suit their domestic circumstances in a wide variety of contexts, including labor relations, environmental policies and human rights, concerns that have sometimes provoked expressions of considerable rage.²⁸ The compromised ability of individual nations to control intellectual property policies, following the linking of these policies to

27. Many commentators have addressed the broader question of the continued viability of the concept of domestic sovereignty in the era of globalization. See, e.g., Drezner, *supra* note 14. Some recognition of the principle of domestic self-determination is reflected in the Preamble to TRIPs, which provides, *inter alia*, “Recognizing the underlying public policy objectives of a national system for the protection of intellectual property, including developmental and technological objectives.” TRIPs, *supra* note 11. The Preamble also provides: “Recognizing . . . the need for new rules and disciplines concerning: . . . (c) the provision of effective and appropriate means for the enforcement of trade-related intellectual property rights, *taking into account differences in national legal systems.*” *Id.* (second emphasis added). It may be, however, that this part of the Preamble refers to the General Obligations as to Enforcement of Intellectual Property Rights in Part III of TRIPs. Article 41.5 of TRIPs recognizes that different nations might have different resources available to enforce infringements of intellectual property rights:

It is understood that this Part does not create any obligation to put in place a judicial system for the enforcement of intellectual property rights distinct from that for the enforcement of laws in general, nor does it affect the capacity of Members to enforce their laws in general. Nothing in this Part creates any obligation with respect to the distribution of resources as between enforcement of intellectual property rights and the enforcement of laws in general.

Id.

28. These have included often quite violent street protests. See Alan Friedman, *Violence Rages at G-8 Talks, Protester Is Killed in Genoa; Leaders Upbeat on Economy*, INT’L HERALD TRIB., July 21, 2001, at 1 (discussing the violent protests at the July 2001 meetings of the “Group of Eight” leaders in Genoa); Ian Black & Michael White, *Sweden Asks: Who Set Off Riots?: ‘Thuggery’ of Protests Against EU-US Talks Condemned*, GUARDIAN (LONDON), June 16, 2001, Foreign Pages, at 13 (discussing protests at June 2001 EU Trade Summit at Gothenburg); Kevin Danaher, *Power to the People*, OBSERVER, April 29, 2001, News Pages, at 25 (discussing various protests against “globalization” and the free trade movement, including the 1999 meetings of the WTO at Seattle).

the world trade regime, has become another focus for these concerns.²⁹ The protests that now surround the political and legal processes of globalization raise critically important questions; however, in this Article, I do not seek to add to attacks on the international intellectual property law edifice.³⁰ For now, it seems that the reality³¹ of international intellectual property law is upon us, a reality that may in many instances serve interests and agenda pursued purely within domestic contexts.³² Accordingly, I do not intend to engage with the important debates that surround the issue of the survival of domestic sovereignty in the intellectual property law context, either as a descriptive or normative matter, in a globalized world. Indeed, elsewhere I have argued that neglect of the international intellectual property system in the development of domestic doctrine may itself be problematic.³³ Adopting an evolutionary approach over a revolutionary one, this Article seeks to find scope for expression of the values associated with domestic self-determination in the international intellectual property law regime that is currently emerging. It thus posits the value of domestic self-determination as something that might influence the processes of forging international intellectual property jurisprudence, rather than seeking to engage with those processes head-on.

29. See generally NAOMI KLEIN, *NO LOGO* (2001).

30. For compelling critiques of the globalization of intellectual property, including the deleterious effects of TRIPs on domestic economies and broader welfare interests of particular nations, see JAMES BOYLE, *SHAMANS, SOFTWARE, AND SPLEENS* 34 (1996) (referring to intellectual property ownership as the equivalent of an "intellectual land grab"); VANDANA SHIVA, *BIOPIRACY* (1997); Rosemary J. Coombe, *Left Out on the Information Highway*, 75 OR. L. REV. 237, 245-47 (1996) (describing the harmonization of global intellectual property laws as "inequitable"); Ruth Gana Okediji, *Copyright and Public Welfare in Global Perspective*, 7 IND. J. GLOBAL LEGAL STUD. 117 (1999) (arguing that harmonized international intellectual property law is not likely to produce net welfare gains for the United States or internationally); see also KLEIN, *supra* note 29. These and other commentators have suggested that the imposition of foreign intellectual property norms on domestic law has caused and will in the future impose considerable hardship on particular nations. See, e.g., Henry M. Charkava, *International Copyright and Africa: The Unequal Exchange*, in *COPYRIGHT AND DEVELOPMENT: INEQUALITY IN THE INFORMATION AGE* 13-34 (Philip G. Altbach ed., 1995); Samuel A. Oddi, *The International Patent System and Third World Development: Reality or Myth?*, 1987 DUKE L.J. 831.

31. See Graeme B. Dinwoodie, *The Development and Incorporation of International Norms in the Formation of Copyright Law*, 62 OHIO ST. L.J. 733, 734 (2001) ("International copyright law is suddenly very real.").

32. See generally Graeme B. Dinwoodie, *The Integration of International and Domestic Intellectual Property Lawmaking*, 23 COLUM.-VLA J.L. & ARTS 307 (2000).

33. See Austin, *Isolationism*, *supra* note 21.

Professor Dinwoodie's recent scholarship³⁴ has drawn attention to the important task ahead of identifying and developing policies and values that will assist in the shaping of international intellectual property jurisprudence. As we engage with this task, it is important that the territoriality principle—and the possibilities for domestic self-determination it allows—should not come to be regarded as an irritating distraction in the seemingly inexorable drive toward uniform international standards. Rather, I suggest that valuing domestic self-determination might contribute to the formulation of international intellectual property jurisprudence in the various contexts in which this process occurs: both doctrinally, in the forging of public and private international law, and institutionally, as we come to think about which institutions might be involved in that process. Just as efficiency is an important policy aim informing this process, so too, it is suggested, is the ability of individual nations to develop intellectual property laws in accordance with domestic needs. However, in the current environment, there is a risk that we may lose sight of the importance of domestic self-determination as the upward harmonization agenda continues to gain momentum.³⁵

Part I of this Article examines the role of territoriality in public and private international intellectual property law, and suggests that these bodies of law are animated by both internationalist and territorialist impulses. Part II discusses the importance of identifying the values that might inform the continued development of international

34. Graeme B. Dinwoodie, *A New Copyright Order: Why National Courts Should Create Global Norms*, 149 U. PA. L. REV. 469 (2000); see also Laurence R. Helfer & Graeme B. Dinwoodie, *Designing Non-National Systems: The Case of the Uniform Domain Name Dispute Resolution Policy*, 43 WM. & MARY L. REV. 141 (2001).

35. Of course, where particular domestic nations assert their own policy perspectives, particularly in public international law contexts, the point that this is an expression of at least a *desire* for domestic self-determination is a rather obvious one. The recent "concessions" at the WTO Doha meeting regarding compulsory licensing for pharmaceuticals provides a very recent example. See text at note 97, *infra*. Often, the individual claims of domestic nations are portrayed in opposition to the drive toward supranational standards. See Aoki, *supra* note 9, at 443 ("There is a marked trend toward favoring ideas like 'upward harmonization' and other universalizing moves and a concomitant discounting or erasure of the 'local,' with disturbing effects on the political economy of information that flows through global networks such as the Internet."). While that is likely to be true as an empirical matter in numerous cases, my purpose is not to engage in detailed discussion of this critically important topic. Rather, it is to explore ways that valuing domestic self-determination might enter discussion of the formulation of international intellectual property jurisprudence in a variety of contexts, including both public and private international law. In addition, the value of domestic self-determination may be a useful reference (one of many) against which to test new initiatives, such as that proposed by Professors Dreyfuss and Ginsburg in this Volume. See Rochelle C. Dreyfuss & Jane C. Ginsburg, *Draft Convention on Jurisdiction and Recognition of Judgments in Intellectual Property Matters*, 77 CHI.-KENT L. REV. 1065 (2002) (in this issue).

intellectual property jurisprudence. It first considers the difficulty of identifying discrete "intellectual property" values, and suggests that the values that ought to inform the development of jurisprudence in this area need to be drawn from broader concerns associated with the cultural, economic, and political organization of domestic nations. Some of the normative claims that can be made for valuing domestic self-determination in intellectual property laws are then explored, drawing in part on the work of John Rawls in his text, *The Law of Peoples*.³⁶ Rawls's work provides a useful source of ideas for helping us think through ways of resolving the tension between domestic self-determination and untrammelled expressions of domestic self-interest by individual nations. Part II goes on to speculate, in a preliminary manner, on some of the ways that the value of domestic self-determination might contribute to international intellectual property jurisprudence.

Part III turns to the draft treaty proposal by Professors Dreyfuss and Ginsburg that is the subject of the principal paper in this Symposium.³⁷ This is a major contribution to the development of international intellectual property jurisprudence. Building on the draft Hague Convention on Jurisdiction and the Enforcement of Judgments,³⁸ the Dreyfuss-Ginsburg proposal seeks to establish uniform and predictable rules for determining the circumstances in which a forum may assert jurisdiction over intellectual property litigation that has significant foreign elements. In addition, the draft treaty seeks to impose standard rules for the enforcement of judgments in intellectual property cases. Part III considers the extent to which the Dreyfuss-Ginsburg proposal supports the value of domestic self-determination in intellectual property matters. Given that the focus of the Dreyfuss-Ginsburg proposal is jurisdiction and enforcement,³⁹ rather than choice of law,⁴⁰ this might seem an odd line of inquiry. As Professors Dreyfuss and Ginsburg recognize, the neutrality of their draft treaty on issues of choice of law may contribute to its acceptability and enhance the possibility of its adoption.⁴¹ However, juris-

36. JOHN RAWLS, *THE LAW OF PEOPLES* (1999).

37. Dreyfuss & Ginsburg, *supra* note 35.

38. Hague Conference on Private International Law, Preliminary Draft Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters, at <http://www.hcch.net/e/workprog/jdgm.html> (last visited May 25, 2002) [hereinafter Hague draft].

39. Dreyfuss & Ginsburg, *supra* note 35.

40. *See id.* at 1086 (art. 25).

41. *See id.*

diction and choice of law are not hermetically sealed topics: as a very practical matter, fora are frequently selected because it is anticipated that some substantive advantage might follow,⁴² suggesting that it is important to scrutinize jurisdictional rules in the light of the choice(s) of law(s) that might follow. Choice of law principles that lead to an overexpansive application of the forum's law, at the expense of laws that have been developed in and for the territory in which infringements take place, may be difficult to reconcile with the value of domestic self-determination. Some of the principles articulated in the Dreyfuss-Ginsburg draft treaty and the accompanying commentary appear supportive of the view that an individual nation has an appropriate interest in the intellectual property laws that are applied to activities within its territory.⁴³ However, the scope that Professors Dreyfuss and Ginsburg seem to allow for application of these principles is somewhat less clear.⁴⁴

I. TERRITORIALITY IN PUBLIC AND PRIVATE INTERNATIONAL INTELLECTUAL PROPERTY LAW

The territorial quality of intellectual property rights once provided a riposte to statements heard so often to the effect that Country A loses billions of dollars as a result of the condition of intellectual property laws in Country B.⁴⁵ The riposte was that such statements beg an important question. Losses are only meaningful if some right existed according to the laws of Country B that have been infringed. In general, intellectual property rights are created through bureaucratic action, in the case of patents and registered trademarks, or are creatures of, and depend for their existence on, individual nations'

42. See RUSSELL J. WEINTRAUB, COMMENTARY ON THE CONFLICT OF LAWS § 4.33A (4th ed. 2001); see also *Ferens v. John Deere Co.*, 494 U.S. 516, 526 (1990) ("Some plaintiffs would prefer to litigate in an inconvenient forum with favorable law than to litigate in a convenient forum with unfavorable law or not to litigate at all.") (Kennedy, J.).

43. See Part III, *infra*.

44. *Id.*

45. See Eric H. Smith, *Worldwide Copyright Protection Under the TRIPS Agreement*, 29 VAND. J. TRANSNAT'L L. 559 (1996) (gathering estimates of losses to US copyright industries caused by offshore piracy of copyright goods); see also INT'L INTELLECTUAL PROP. ALLIANCE, PIRACY OF U.S. COPYRIGHTED WORKS IN TEN SELECTED COUNTRIES (1985), cited in MICHAEL P. RYAN, KNOWLEDGE DIPLOMACY 71 (1998). Views to this effect continue to be expressed by organizations such as the Business Software Alliance (identifying \$11.75 billion in losses due to piracy in 2000). See BUS. SOFTWARE ALLIANCE, SIXTH ANNUAL BSA GLOBAL SOFTWARE STUDY 1 (2001), available at <http://www.bsa.org/resources/2001-05-21.55.pdf>; IFPI, 2001 IFPI MUSIC PIRACY REPORT, at <http://www.ifpi.org/site-content/library/piracy2001.pdf> (claiming that "[m]usic piracy poses a greater threat to the international music industry than at any other time in its history") (last visited April 29, 2002).

domestic lawmaking initiatives, as is the case with copyright. Within a strict territorialist perspective, if Country B did not choose to create or provide for these rights, intellectual property owners in Country A could not complain of having "lost" anything at all in Country B. Proprietors of intellectual property rights in Country A had nothing in Country B of which they had been deprived.

Informing complaints about losses in foreign territories is a vision of intellectual property rights as being of a supranational character, a vision that may have once been little cognizant of the territorial reality of international intellectual property relations. Today, that supranational vision and the emerging international legal reality are as close as they have ever been. The territorialist perspective is being supplemented by supranational norms that are emerging apace at the public international law level and other policies that respond to the modern circumstances in which intellectual property is often created in the context of international collaborations, and can be and rendered instantly available almost everywhere.

That said, the territoriality principle remains influential in many intellectual property contexts, and continues to shape commercial decision making within individual jurisdictions. A recent episode in New Zealand illustrates the importance of territoriality to commercial and artistic decisions relating to the exploitation of intellectual property rights. In 2001, the New Zealand Symphony Orchestra announced that it was producing a compact disc featuring a performance of Hungarian composer Béla Bartók's viola concerto, a work that remained unfinished at the composer's death in the United States in 1945.⁴⁶ Many previous performances of this concerto used the version completed by the composer's friend, Tibor Serley, though Bartók's son had commissioned a new version of the work in 1995.⁴⁷ The New Zealand Symphony Orchestra wanted to perform and record a further "new" version of the concerto, the work of a local musicologist who apparently did not rely on the earlier reworkings from Bartók's manuscript.

46. Commentators have noted that Bartók's compositional efforts close to the end of his life were motivated, at least in part, by the desire to provide his family with an income after his death. See THE GROVE CONCISE DICTIONARY OF MUSIC 59–60 (1988).

47. One of the recordings of the Bartók-Serley version of the concerto is Hong-Mei Xiao & Budapest Philharmonic Orchestra, *Viola Concerto, for Viola and Orchestra, Sz. 120 BB 128*, on BARTÓK VIOLA CONCERTOS (NAXOS 1998).

Release of the new version of the Bartók concerto was to be a significant event in musical circles.⁴⁸ However, immediately prior to the commercial release of the recording, it was reported that the composer's son threatened the New Zealand Symphony Orchestra with a copyright infringement action.⁴⁹ Media reports also recounted the Orchestra's CEO as saying that he had taken legal advice on the matter, and had relied on the territorial quality of copyright laws in both his marketing strategies and in his defense to the allegations raised by Bartók's heir.⁵⁰ While the underlying Bartók composition may have remained within copyright protection in the United States,⁵¹ it had fallen into the public domain in New Zealand, whose copyright laws provide for a shorter term.⁵² The orchestra acknowledged that it would not be able to sell the work in countries that provide a longer copyright term for the underlying composition. In Australia and New Zealand, however, the orchestra's management believed that the production and sales would be lawful.

Legislative models for increased copyright terms have long been available to New Zealand lawmakers.⁵³ Perhaps for very good reason,⁵⁴ they have decided not to adopt them. Assuming that the recording of the Bartók viola concerto is a runaway Australasian success, would the sales of the compact disc be an example of losses

48. Serley's version has apparently long been charged with "inauthenticity": the composer's son, Peter Bartók, has suggested that Serley made significant additions to the score that were not in the sketches left behind at his father's death. See David Isadore Lieberman, *Notes on Concerto for Viola and Orchestra*, at <http://loudounsymphony.org/notes/bartok-viol.html> (last visited Apr. 19, 2002).

49. *NZSO and the Expensive Concerto*, NEWSROOM, Aug. 21, 2001, at <http://www.newsroom.co.nz/story/61082-99999.html>.

50. *Id.*

51. In general, a work composed in 1945 may be protected in the US for ninety-five years, assuming all formalities are complied with and renewal terms registered. 17 U.S.C. § 304 (2002).

52. Copyright Act (N.Z.), sec. 22(1) (copyright in literary, dramatic, musical and artistic works expire at the end of the period of fifty years from the end of the calendar year in which the author dies); Copyright Act 1968 (Aust.), sec. 33(2) (same).

53. Two models are from the United States and the European Union: Sonny Bono Copyright Term Extension Act of 1998 Tit. I, Pub. L. No.105-298, 112 Stat. 2827; Council Directive 93/98 EEC of 29 October 1993, Harmonizing the Term of Protection of Copyright and Certain Related Rights, art. 1, 1993 O.J. (L 290) 9. See generally Lisa M. Brownlee, *Recent Changes in the Duration of Copyright in the United States and European Union: Procedure and Policy*, 6 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 579 (1996).

54. Perceived problems with the Sonny Bono Copyright Term Extension Act led to a constitutional challenge. See *Eldred v. Reno*, 239 F.3d 372 (D.C. Cir. 2001) (upholding the Act's constitutionality), *cert. granted sub nom. Eldred v. Ashcroft*, 122 S. Ct. 1062 (2002), *cert. amended by* 122 S. Ct. 1170 (2002). For discussion of some of the policy concerns to which the extension of US copyright terms has given rise, see Jane C. Ginsburg, *Copyright Legislation for the "Digital Millennium,"* 23 COLUM.-VLA J.L. & ARTS 137, 171-75 (1999).

inflicted on foreign intellectual property owners who are deprived of a stream of royalties that was "rightfully" theirs? Or should the New Zealand laws that lead to this result be characterized as a valid exercise of domestic sovereignty, allowing a creditable, but underfunded, musical establishment to bring new music to a small part of the world, without the burden of paying royalties to an American estate? Moreover, because of the "public domain" status of the work, New Zealand's domestic copyright laws would allow local musical aficionados to have available recordings of three versions of the viola work to compare: the Bartók/Serley version, the version commissioned by the composer's son, and the latest rendering of the work by the New Zealand Symphony Orchestra.

Images of the nations that provide no or lesser protection in a particular instance, and of "rogue" or "pirate" nations that provide no protection at all,⁵⁵ seem to prompt different intuitive responses,⁵⁶ particularly where a nation doing something different actually complies with its public international law obligations.⁵⁷ There may be some who, referring even to the "no protection" case, might respond, "But what if they don't protect intellectual property enthusiastically?"—celebrating, or, at least, tolerating, this expression of domestic self-determination. It is more likely, however, that complaints about losses sustained by intellectual property proprietors beg the question far less in the "no protection" case.

If there *are* real differences here in our responses, perhaps the differences reflect something about emerging international intellectual property values and policies. In the modern international intel-

55. Whether the current shape of a domestic nation's intellectual property laws on any issue is a product of deliberate policy response or is a product of a *lack* of consideration of a particular issue is a matter of empirical inquiry. Concerns for values associated with domestic sovereignty may suggest that the latter cause is somehow more valid than the former. On the other hand, even a lack of consideration of an issue may be a product of decisions about the appropriate deployment of legislative resources, which itself might be characterized as an important expression of domestic sovereignty. Consideration of like issues has arisen in the state conflict of laws context, when assessment is made of the commitment of each state to the policies that may be overridden following choice of law analysis. See, e.g., *Offshore Rental Co. v. Cont'l Oil Co.*, 583 P.2d 721 (Cal. 1978).

56. For careful consideration of when international law should defer to domestic policy choices in the copyright context, see Ginsburg, *International Copyright*, *supra* note 12, at 284–88 (discussing, in particular, the case for national rules governing ownership rules in the context of employment relationships).

57. For example, the Berne Convention, *supra* note 11, article 7(6), permits member countries to "grant a term of protection in excess of those provided by the preceding paragraphs." The Convention also allows member countries to provide shorter terms in some instances that are not relevant here.

lectual property law environment, “radical supranationality” may be as unhelpful, or, at least, as unrealistic, as “radical territoriality.” The “upward harmonization” agenda that energizes the modern public international law of intellectual property is certainly aimed to generate more protective, and more uniform, intellectual property laws.⁵⁸ At the same time, the upward harmonization agenda is tempered by the continued potency of the territoriality principle in a number of contexts. This is reflected both in the creation of public intellectual property instruments and in their interpretation. Consensus-based lawmaking continues to provide an important, if limited,⁵⁹ check on the development of supranational legal norms, and deference to domestic policies has been an important principle informing the interpretation of public international law instruments. The importance of domestic sovereignty interests has been reflected recently in the announcements made by the World Trade Organization (“WTO”) at the November 2001 meetings in Doha, regarding compulsory licensing of pharmaceuticals and the right of individual nations to determine what constitutes a national emergency.⁶⁰ In private international intellectual property law, a similar dynamic relationship between internationalism and respect for foreign laws is also manifest. In some contexts, domestic courts are quite deferential to the policy choices reflected in foreign intellectual property law systems.⁶¹ In others, however, domestic courts, particularly in the

58. For example, Vietnam, long regarded by the United States as a country whose laws and policies encouraged widespread intellectual property piracy, see Graziella M. Sarno, Comment, *Viet Nam or Bust: Why Trademark Pirates Are Leaving China for Better Opportunities in Viet Nam*, 14 DICK. J. INT’L L. 291 (1996), signed a bilateral trade agreement with the US in 2000, Chapter II of which contains important requirements as to the protection of intellectual property, including a requirement that Vietnam will enact WTO-standard copyright, trademark and patent laws. Agreement between the United States of America and the Socialist Republic of Vietnam on Trade Relations, July 13, 2000, Ch. II, at <http://www.ustr.gov/regions/asia-pacific/text.pdf>.

59. As Professor Dinwoodie has pointed out, consensus-based lawmaking in the public international law of intellectual property has been partly superseded by new models of lawmaking that respond to the dynamic technological and international context for which intellectual property laws now need to be forged. Dinwoodie, *supra* note 34, at 494–501; see also Ruth L. Gana, *The Myth of Development, the Progress of Rights: Human Rights to Intellectual Property and Development*, 18 LAW & POL’Y 315, 334 (1996) (“Given the history of the international intellectual property system, the notion that either the pre- or post-TRIPS multilateral system is based upon consensus is still a myth as far as developing countries are concerned.”).

60. See text at note 100, *infra*.

61. See generally G.W. Austin, *The Infringement of Foreign Intellectual Property Rights*, 113 LAW Q. REV. 321, 332 (1997) (identifying the paradox that jurisdictional reticence, in order to signal respect to foreign sovereignty interests, may have the effect of rendering nugatory the rights created under the law of the foreign sovereign); see also Section I.B., *infra*.

United States, have developed strategies that limit the efficacy of foreign intellectual property laws in favor of extraterritorial application of domestic laws.

A. *Public International Law*

Some responses to perceptions of unjustifiable "losses" to proprietors of intellectual property rights now no longer need to be merely intuitive. Public international law instruments, most notably the TRIPs Agreement,⁶² provide mechanisms for testing whether particular domestic policy choices comply with international norms. Where domestic laws are found wanting, the TRIPs Agreement provides the means for imposing meaningful remedies, including trade sanctions.⁶³ While inconsistencies between certain domestic laws that reflect domestic policy choices and the terms of international intellectual property law instruments have long been recognized, the WTO dispute settlement processes now provide governments with more effective procedural mechanisms for challenging, and, where negotiations or other, more persuasive, processes fail,⁶⁴ requiring the correction of, domestic intellectual property laws that do not pass muster. And as these procedural mechanisms generate substantive results, domestic nations will likely find that past and future attempts to mold intellectual property laws to suit domestic policy agenda may need to be tempered, even rethought in their entirety, in the light of emerging public international intellectual property law doctrine.

One of the key lessons from the body of law relating to intellectual property that is emerging through the WTO dispute settlement processes is that the subjection of intellectual property owners' "rights" to domestic law policies will be tolerated less readily than in the past.⁶⁵ An economic "break" given to certain small businesses

62. TRIPs, *supra* note 11, Annex 1C.

63. WTO Agreement, *supra* note 11, Annex 2, art. 22; *see also* Rochelle Cooper Dreyfuss & Andreas F. Lowenfeld, *Two Achievements of the Uruguay Round: Putting TRIPs and Dispute Settlement Together*, 37 VA. J. INT'L L. 275, 327-32 (1997); J.H. Reichman, *Enforcing the Enforcement Procedures of the TRIPs Agreement*, 37 VA. J. INT'L L. 335 (1997); Sue Ann Mota, *TRIPs: Five Years of Disputes at the WTO*, 17 ARIZ. J. INT'L & COMP. L. 533 (2000).

64. *See generally* J.H. Reichman, *The TRIPs Agreement Comes of Age: Conflict or Cooperation with the Developing Countries?*, 32 CASE W. RES. J. INT'L L. 441 (2000); Adrian Otten & Hannu Wager, *Compliance with TRIPs: The Emerging World View*, 29 VAND. J. TRANSNAT'L L. 391 (1996).

65. *See* India—Patent Protection for Pharmaceutical and Agricultural Chemical Products, WT/DS50/R (WTO Panel Sept. 5, 1997), *aff'd*, WR/DS50/AB/R (WTO App. Body Dec. 19,

wishing to rebroadcast music,⁶⁶ the ability of pharmaceutical companies to stockpile generic pharmaceuticals ready to go to market at the end of a proprietary drug's patent term,⁶⁷ a decision not to extend terms for older patents⁶⁸—these all represented domestic policy choices about the nature and extent of intellectual property proprietors' rights within particular domestic borders. In whole or in part, however, these domestic policy choices are no longer acceptable according to public international law norms, as interpreted and applied by WTO panels. For US economic interests, where the WTO processes cannot be relied on, the threat of "Special 301" sanctions may achieve significant substantive changes to domestic intellectual property laws, broadly in line with dominant international patterns.⁶⁹ The agenda of international standardization can also be progressed by bilateral⁷⁰ or multilateral⁷¹ trade agreements. The development of

1997); Canada—Patent Protection of Pharmaceutical Products, WR/DS114/R (WTO Panel Mar. 17, 2000) [hereinafter Canada Stockpiling Report]; Canada—Term of Patent Protection, WT/DS170/R (WTO Panel May 5, 2000) [hereinafter Canada Patent Term Report]; U.S.—Section 110(5) of the U.S. Copyright Act, WT/DS160/R (WTO Panel June 15, 2000) [hereinafter Panel Report].

66. Panel Report, *supra* note 65.

67. Canada Stockpiling Report, *supra* note 65.

68. Canada Patent Term Report, *supra* note 65.

69. "Special 301" refers to a procedure introduced by the Trade Act of 1974, Pub. L. No. 93-618, 88 Stat. 1978 (1975), providing for action to be taken against US trading partners engaging in "unfair competition." These powers were extended by the Omnibus Trade and Competitiveness Act of 1998, 19 U.S.C. §§ 2411-2420 (2002), which vests the US Trade Representative ("USTR") with the power of determining which countries to investigate, investigations which may lead to retaliation. The amended procedures require the USTR to annually list countries that allow for the most flagrant violations of protection for US intellectual property. A "Priority Foreign Country" is a country that *inter alia* engages in the most egregious practices that deny protection or equitable market access on the relevant US products. The Special 301 procedure was used famously with respect to China, which in 1991 was listed as a Priority Foreign Country for failing to adequately protect patents and copyright, with deleterious effects for US products, especially computer software. Following lengthy negotiations between China and the US, a Memorandum of Understanding was signed between the two countries in 1992, immediately before the US was about to take retaliatory action against China. The Memorandum contributed significantly to the enactment of intellectual property laws in China in line with Western norms. China joined the WTO on December 11, 2001. *China WTO Member*, STATESMAN, Dec. 12, 2001, available at 2001 WL 30169616. For detailed analysis of the Special 301 procedures, see Kim Newby, *The Effectiveness of Special 301 in Creating Long Term Copyright Protection for U.S. Companies Overseas*, 21 SYRACUSE J. INT'L L. & COM. 29 (1995).

70. The recently completed free trade agreement between Vietnam and the United States is an example of a bilateral trade agreement requiring significant changes in a domestic nation's intellectual property laws in order to comply with international standards. See *supra* note 58 and accompanying text.

71. See, e.g., Draft Agreement, Free Trade Area of the Americas, July 3, 2001, available at http://www.ftaa-alca.org/ftaadraft/eng/draft_e.asp. The document, with origins in a 1994 Summit of the Americas, is aimed to remove barriers to trade and investment among all the states in the Western Hemisphere. The draft agreement includes a "Chapter on Intellectual

standardized procedural and substantive norms within regional contexts, particularly within the European Union, represents the most vigorous commitment to removing the friction caused by diversity between national legal systems.⁷²

1. Consensus-based Lawmaking

At the same time, public international intellectual property jurisprudence continues to reflect the dynamic relationship between territorialist and internationalist approaches to the development of intellectual property law. While public international intellectual property laws create global or regional norms against which domestic policies and laws may be tested, a complementary perspective, one that continues to be promoted by the classic public international lawmaking model,⁷³ is that some degree of international consensus should be achieved before new norms are promulgated. This approach reflects the idea that some common ground should be found amongst nations with diverse approaches to the content and societal purposes implicated by the particular issue under scrutiny. In the intellectual property context, one of the earliest indications of the importance of consensus was the reception of the suggestion by the German delegates to the 1883 intergovernmental meeting to form the Berne Union that the national treatment principle be abandoned in favor of a uniform international copyright law.⁷⁴ The idea, put before the meeting by way of a questionnaire, was rejected partly for practical reasons: it would have required significant modifications of the international delegates' domestic copyright laws, which could not

Property Rights," which, in addition to requiring compliance with now standard international intellectual property principles, also requires parties to enact laws substantially equivalent to 17 U.S.C. section 1201(a)(1)(A), which creates a distinct tort for circumventing technological measures. *Id.* This standard arguably goes beyond the 1996 WIPO Copyright Treaty, which requires only that member states provide "legal remedies against the circumvention of effective technological measures that are used by authors in connection with the exercise of their rights under this Treaty or the Berne Convention and that restrict acts, in respect of their works, which are not authorized by the authors concerned or permitted by law." WIPO Copyright Treaty, *supra* note 11, art. 11; *see also* WIPO Performances and Phonograms Treaty, *supra* note 11, art. 18 (containing same requirements with respect to acts not authorized by performers or the producers of phonorecords, or permitted by law).

72. For discussion on the standardization of intellectual property laws within the European Union, *see supra* note 20 and accompanying text.

73. *See generally* Dinwoodie, *supra* note 34, at 490–94 (discussing the classic public international lawmaking model in the copyright context, and evaluating its problems, including the considerable time needed to achieve international consensus).

74. SAM RICKETSON, THE BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS: 1886–1986, at 39–40 (1987).

have been achieved in time.⁷⁵ In subsequent drafts, the universalist approach dropped away in favor of an approach that would allow more countries to accede to the Convention.⁷⁶

As Professor Dinwoodie has cogently demonstrated in his recent scholarship on the development of international copyright law, the classic, consensus-based model has been superseded on a number of fronts.⁷⁷ In part, the developments he describes are motivated by the need to allow international intellectual property law to develop without consensus, in order to respond more rapidly to technological and other challenges.⁷⁸ The continued drive toward international privatization of intellectual property issues is consistent with this theme. For instance, the Uniform Dispute Resolution Policy (“UDRP”)⁷⁹ has, for most practical purposes,⁸⁰ taken important disputes touching on the regulation of trademark rights out of the hands of domestic tribunals, displacing them by arbitration-like processes, regulated by the UDRP code and the private institution of contract.⁸¹

However, two recent international intellectual policy initiatives reflect the continued importance of deference to differences between domestic laws. In its September 2001 report, *The Recognition of*

75. Ginsburg, *supra* note 12, at 268.

76. *Id.* at 269–70.

77. Dinwoodie, *supra* note 34, at 493.

78. See RYAN, *supra* note 45, at 141 (describing TRIPs in terms of “‘deep integration’—harmonizing the policies and laws of developing countries with those of the global community—initiated by American multinational corporations and foreign policymakers”) (citation omitted); see also Dinwoodie, *supra* note 34, at 494 n.87 (discussing the US constitutional arrangements that allowed for “fast-track” ratification of the North American Free Trade Agreement and the General Agreement on Tariffs and Trade). In addition, Professor Dinwoodie characterizes the various EC directives relating to intellectual property rights in terms of the shift away from consensus-based international lawmaking. *Id.* at 497.

79. ICANN, Uniform Dispute Resolution Policy, (Oct. 24 1999), at <http://www.icann.org/udrp/udrp-policy-24oct99.htm> [hereinafter UDRP].

80. The UDRP does not oust the jurisdiction of domestic courts. *Id.* art. 4(k) (providing that UDRP proceedings shall not prevent either party from “submitting the dispute to a court of competent jurisdiction for independent resolution”); see also WIPO, *The Management of Internet Names and Addresses: Intellectual Property Issues: Final Report of the WIPO Internet Domain Name Process*, para. 150(v), at <http://wipo2.wipo.int/process1/report/finalreport.html> (Apr. 30, 1999). US courts have interpreted the UDRP consistently with this view. See *Broadbridge Media, LLC v. Hypercd.com*, 106 F. Supp. 2d 505, 508–09 (S.D.N.Y. 2000); *Weber-Stephen Prods. Co. v. Armitage Hardware & Bldg. Supply, Inc.*, 54 U.S.P.Q.2d 1766 (N.D. Ill. 2000); *Sallen v. Corinthians Licenciamentos LTDA*, 273 F.2d 14 (1st Cir. 2001).

81. The legal operation of the UDRP is based in part on subscription agreement between a subscriber and the online service provider. For an exhaustive analysis of the legal underpinnings of the UDRP processes, see Helfer & Dinwoodie, *supra* note 34. See also Wayde Brooks, *Wrestling Over the World Wide Web: ICANN’s Uniform Dispute Resolution Policy for Domain Name Disputes*, 22 HAMLINE J. PUB. L. & POL’Y 297 (2001).

Rights and the Use of Names in the Internet Domain Name System,⁸² promulgated as part of the Second Internet Domain Name Process,⁸³ WIPO considered a range of responses to identifiers other than trademarks: international nonproprietary names for pharmaceutical substances, the names and acronyms for international intergovernmental organizations, personal names, geographical identifiers, and trade names.⁸⁴ WIPO appeared to be most reticent in areas in which it could not identify an international consensus as to the levels of protection for these identifiers.⁸⁵ With respect to personal names and geographical indicators, WIPO considered that there was insufficient international consensus to allow firm recommendations to be made as to their treatment within the UDRP system, and identified a need for decisions to be made by the "international community" as to whether more protective laws should be developed.⁸⁶ Concerning trade names, WIPO recognized that, though some international norms could be identified, "fundamental problems exist in identifying across differing national approaches what constitutes a protectable trade name."⁸⁷ The difficult choice of law issues that might arise in this context as a result of this diversity prompted WIPO to recommend that no action be taken in the area of trade names.⁸⁸ As a general note of deference, WIPO concluded: "It will be for the international community to choose not only whether it wishes to make new rules to deal with any of the identifiers examined in this Report, but also how it may wish to develop such rules and implement them."⁸⁹

The Second Domain Name Process was, however, also characterized as contributing to deliberations by domestic nations as to whether they should respond to "the insufficiencies of the current international legal framework"⁹⁰ regulating the use of these identifiers. The work by international agencies such as WIPO in drawing attention to gaps in current domestic responses to protection of these

82. THE RECOGNITION OF RIGHTS AND THE USE OF NAMES IN THE INTERNET DOMAIN NAME SYSTEM: REPORT OF THE SECOND WIPO INTERNET DOMAIN PROCESS, at <http://wipo2.wipo.int/process2/report/pdf/report.pdf> (Sept. 3, 2001).

83. *Id.* at v.

84. *Id.*

85. *Id.* at vi.

86. *Id.* at vii–viii.

87. *Id.* at viii.

88. *Id.*

89. *Id.* at vii.

90. *Id.* at vi.

identifiers may prompt action at the domestic level, enhancing the possibility for supranational solutions.⁹¹

Similarly, the recently promulgated *WIPO and Paris Union Joint Recommendation on the Protection of Marks on the Internet*⁹² reflects both WIPO's⁹³ overarching aim of accelerating the harmonization of international intellectual property laws and a significant degree of deference to domestic laws.⁹⁴ The *Joint Recommendation* includes a number of important suggestions as to how domestic laws might be crafted to deal with the problem that "a sign used on the Internet is simultaneously and immediately accessible irrespective of territorial location."⁹⁵ The *Joint Recommendation* includes detailed provisions on the use of trademarks on the Internet and suggested rules for establishing whether such use has actionable commercial effects within particular jurisdictions.

With the *Joint Recommendation*, WIPO did not seek to impose new supranational norms on domestic nations. Rather, as is described in its Preamble, its purpose is to recommend to member states of the Paris Union and of WIPO that they "consider the use of any of the provisions . . . as guidelines concerning the protection of marks, and other industrial property rights in signs, on the Internet."⁹⁶ It is of course possible that, over time, the *Joint Recommendation* may come to represent an international norm. Even without domestic legislative initiatives, it may, for instance, be adopted by parties to arbitrations. For present purposes, its importance is not so much in the details of the proposal but in the technique deployed for its adoption: persuasion, rather than international fiat.

Also reflecting the continued importance of domestic concerns is the recent declaration from the WTO at its November 2001 Doha meeting concerning the ability of individual nations to take measures

91. On the role of WIPO generally in the development of supranational intellectual property norms, see RYAN, *supra* note 45, at 125–39.

92. WIPO & PARIS UNION FOR THE PROTECTION OF INDUSTRIAL PROPERTY, JOINT RECOMMENDATION CONCERNING PROVISIONS ON THE PROTECTION OF MARKS AND OTHER INDUSTRIAL PROPERTY RIGHTS IN SIGNS ON THE INTERNET (Oct. 3, 2001), at http://www.wipo.org/about-ip/en/development_iplaw/pub845.htm [hereinafter JOINT RECOMMENDATION]. For detailed analysis of the WIPO/Paris Union Joint Recommendation, see Graeme W. Austin, *Trade Marks On-Line: The WIPO and Paris Union Joint Recommendation on the Protection of Marks on the Internet*, 8 N.Z. BUS. L.Q. 92 (2002).

93. Reference will be made only to "WIPO," rather than to both "WIPO and the Paris Union." (WIPO is the administrative body for the Paris Union.)

94. JOINT RECOMMENDATION, *supra* note 92, at Preface.

95. *Id.* at pmb1.

96. *Id.* at Joint Recommendation.

to protect public health, even if such measures might implicate the intellectual property rights in pharmaceutical patents owned by foreign interests.⁹⁷ The WTO declared that the TRIPs Agreement "does not and should not prevent Members from taking measures to protect public health," and affirmed that the TRIPs Agreement "can and should be interpreted and implemented in a manner supportive of WTO Members' right to . . . promote access to medicines for all."⁹⁸ Operationally, the WTO Doha declaration will likely be given effect through compulsory license regimes; the declaration confirms that "[e]ach Member has the right to grant compulsory licenses and the freedom to determine the grounds upon which such licenses are granted."⁹⁹ In addition, each Member has the right to determine what constitutes a national emergency or other circumstances of extreme urgency.¹⁰⁰ Recognizing that developing countries that have insufficient or no manufacturing capacities in the pharmaceutical sector could face difficulties in making effective use of compulsory licensing under the TRIPs Agreement, the TRIPs Council has been instructed to "find an expeditious solution to this problem and report to the General Council before the end of 2002."¹⁰¹

2. Interpretation and Application of International Law Instruments

Once operative, international intellectual property instruments require interpretation and application. Again, the interpretive processes evince something of the dynamic relationship between internationalist aspirations and the enduring importance of deference to domestic laws. For instance, the recent decision of a panel of the Dispute Settlement Body of the WTO on section 110(5)(A) and (B) of the US Copyright Act¹⁰²—the first international judicial decision to interpret provisions in the TRIPs Agreement and the Berne Conven-

97. See WTO, *Declaration on the TRIPs Agreement and Public Health*, at http://www.wto.org/english/thewto_e/minist_e/min01_e/mindecl_trips_e.pdf (Nov. 14, 2001); see also *Doha Conference Spells Gains for Indian Drug Firms*, BUS. STANDARD, Nov. 20, 2001, at 4; Veena Jha, *Doha: You Might Trip Over the Fine Print*, ECON. TIMES, Nov. 19, 2001, available at 2001 WL 21943350.

98. WTO, *supra* note 97, ¶ 4.

99. *Id.* ¶ 5(b).

100. *Id.* ¶ 5(c).

101. *Id.* ¶ 6; see also *WTO OKs Compromise TRIPs Declaration on Cheap Drug Access for LDCs*, MARKETLETTER, Nov. 19, 2001, available at 2001 WL 9081838; T.N.C. Rajagopalan, *TRIPs May Ground India's Hopes for Patent Waiver*, BUS. STANDARD, Nov. 26, 2001, at 2; Jayanta Ghosh, *No Gains from Doha, Say Pharma Firms*, TIMES INDIA, Nov. 27, 2001, available at 2001 WL 30779689.

102. Panel Report, *supra* note 65.

tion that delimit the scope of exemptions to copyright owners' rights—reflects both an impulse to curb domestic law approaches to exemptions from the rights of copyright owners and deference to policy choices made by individual nations.¹⁰³

The WTO panel found that the “small business” exemption provided for by the US Copyright Act¹⁰⁴ went further than was an-

103. See Dinwoodie, *supra* note 31, at 764–66 (distinguishing between the outcome of the US section 110(5) case and the reasoning of the panel, which was deferential to domestic autonomy at several points in its analysis).

104. 17 U.S.C. § 110(5) provides:

(A) except as provided in subparagraph (B), communication of a transmission embodying a performance or display of a work by the public reception of the transmission on a single receiving apparatus of a kind commonly used in private homes [is not infringement of copyright], unless—

(i) a direct charge is made to see or hear the transmission; or

(ii) the transmission thus received is further transmitted to the public;

(B) communication by an establishment of a transmission or retransmission embodying a performance or display of a nondramatic musical work intended to be received by the general public, originated by a radio or television broadcast station licensed as such by the Federal Communications Commission, or, if an audiovisual transmission, by a cable system or satellite carrier, if—

(i) in the case of an establishment other than a food service or drinking establishment, either the establishment in which the communication occurs has less than 2,000 gross square feet of space (excluding space used for customer parking and for no other purpose), or the establishment in which the communication occurs has 2,000 or more gross square feet of space (excluding space used for customer parking and for no other purpose) and—

(I) if the performance is by audio means only, the performance is communicated by means of a total of not more than 6 loudspeakers, of which not more than 4 loudspeakers are located in any 1 room or adjoining outdoor space; or

(II) if the performance or display is by audiovisual means, any visual portion of the performance or display is communicated by means of a total of not more than 4 audiovisual devices, of which not more than 1 audiovisual device is located in any 1 room, and no such audiovisual device has a diagonal screen size greater than 55 inches, and any audio portion of the performance or display is communicated by means of a total of not more than 6 loudspeakers, of which not more than 4 loudspeakers are located in any 1 room or adjoining outdoor space;

(ii) in the case of a food service or drinking establishment, either the establishment in which the communication occurs has less than 3,750 gross square feet of space (excluding space used for customer parking and for no other purpose), or the establishment in which the communication occurs has 3,750 gross square feet of space or more (excluding space used for customer parking and for no other purpose) and—

(I) if the performance is by audio means only, the performance is communicated by means of a total of not more than 6 loudspeakers, of which not more than 4 loudspeakers are located in any 1 room or adjoining outdoor space; or

(II) if the performance or display is by audiovisual means, any visual portion of the performance or display is communicated by means of a total of not more than 4 audiovisual devices, of which not more than one audiovisual device is located in any 1 room, and no such audiovisual device has a diagonal screen size greater than 55 inches, and any audio portion of the performance or display is communicated by means of a total of not

anticipated by the three-step test provided by article 13 of the TRIPs Agreement for assessing exemptions to copyright law in domestic laws.¹⁰⁵ That test requires that permissible exemptions be (1) limited to certain special cases, which (2) do not conflict with a normal exploitation of a work, and (3) do not unreasonably prejudice the legitimate interests of the right holder.¹⁰⁶ Notwithstanding the adverse outcome for the United States on the small business exception, the panel report was deferential to domestic law policies at a number of points. One of the most pertinent aspects of the panel report for US intellectual property policy, particularly in the field of copyright, is the panel's approach to the meaning of "certain" in the three-part test. The panel interpreted "certain" to mean "clearly defined"; a defense afforded by a domestic legal system could be valid without having to "identify each and every possible situation to which the exception could apply."¹⁰⁷ The panel's analysis appears to be quite deferential to nations, such as the United States, whose copyright laws deploy a broad "fair use" defense in addition to more narrowly carved exceptions to copyright protections. Many other nations adopt only the latter system of exceptions.¹⁰⁸ The US fair use doctrine possibly succeeds under the first limb, in that the existence of the defense and something about its character is clearly ascertainable from section 107 of the Copyright Act 1976.¹⁰⁹ However, the fair use

more than 6 loudspeakers, of which not more than 4 loudspeakers are located in any 1 room or adjoining outdoor space;

- (iii) no direct charge is made to see or hear the transmission or retransmission;
- (iv) the transmission or retransmission is not further transmitted beyond the establishment where it is received; and
- (v) the transmission or retransmission is licensed by the copyright owner of the work so publicly performed or displayed.

17 U.S.C. § 110(5) (2002).

105. Article 13 of TRIPs, *supra* note 11, reads: "Members shall confine limitations or exceptions to exclusive rights to certain special cases which do not conflict with a normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the right holder."

106. *Id.*; Panel Report, *supra* note 65. For commentary on the role of exception clauses in the development of domestic and international copyright principles, see Sam Ricketson, *The Boundaries of Copyright: Its Proper Limitations and Exceptions—International Conventions and Treaties*, 1999 INTELL. PROP. Q. 56; Shira Perlmutter, *Future Directions in International Copyright*, 16 CARDOZO ARTS & ENT. L.J. 369 (1998).

107. Panel Report, *supra* note 65, ¶ 1.110. However, the panel recognized that the stated legislative purposes might assist in determining whether an exception was sufficiently narrow to qualify within the requirement that the exception be limited to "certain special cases." *See id.*, ¶¶ 6.112, 6.157.

108. *See* Tyler G. Newby, *What's Fair Here Is Not Fair Everywhere: Does the American Fair Use Doctrine Violate International Copyright Law?*, 51 STAN. L. REV. 1633, 1642–46 (1999) (surveying the fair use exceptions of several GATT-member countries other than the US).

109. 17 U.S.C. § 107 provides:

doctrine remains one of “the most troublesome in the whole law of copyright,”¹¹⁰ and it certainly may be characterized as a defense for which it is *not* possible to identify each and every circumstance in which it might apply. Notwithstanding these troublesome aspects of the US approach to defenses, the WTO panel’s approach seems to accommodate it.¹¹¹

Other aspects of the panel’s report also disclose a degree of deference to domestic policy choices. For example, when assessing whether or not an exception amounted to a “special case” for the purposes of article 13 of TRIPs, the panel resisted the conclusion that “an exception or limitation must be justified in terms of a legitimate public policy purpose”.¹¹² The panel recognized that, in the light of a nation’s “own history and national priorities”, an exception might be regarded as “special,” thereby eschewing normative scrutiny of the domestic policy justifications for the exception.¹¹³ The precedential

Notwithstanding the provisions of sections 106 and 106A, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work.

The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors.

17 U.S.C. § 107 (2002).

110. *Dellar v. Samuel Goldwyn, Inc.*, 104 F.2d 661, 662 (2d Cir. 1939); *see also* *Princeton Univ. Press v. Mich. Document Servs. Inc.*, 99 F.3d 1381, 1392 (6th Cir. 1996) (“Fair use is one of the most unsettled areas of [copyright] law.”).

111. *Dinwoodie*, *supra* note 31, at 751. *See also* *Newby*, *supra* note 108 (concluding that the US fair use defense, as it is applied by US Courts, is consistent with article 13 of TRIPs). For a different analysis, *see* Ruth Okediji, *Toward an International Fair Use Doctrine*, 39 COLUM. J. TRANSNAT’L L. 75 (2000).

112. Panel Report, *supra* note 65, at ¶ 6.113.

113. *See* *Dinwoodie*, *supra* note 31, at 765–66 (discussing the difference between the panel’s analysis of the “special cases” requirement, which eschewed a normative analysis, and other aspects of the panel’s analysis of article 13 of TRIPs, where the panel did engage in more normative analysis of the justifications for the exceptions). For example, when discussing the normalcy of the means of exploitation that was the subject of the limitation or exception, the panel observed that one way of assessing this was to consider whether the use of the copyright work permitted by the limitation or exception competed economically with the rights holders’ exploitation of the work. A use that did compete economically with ways that rights holders normally derive income from a work (taking into account future uses) would be more likely to be regarded as conflicting with the normal exploitation of the work. *See* Panel Report, *supra* note 65, at ¶¶ 1.181, 1.183.

value of WTO panel adjudications remains uncertain.¹¹⁴ However, the panel's suggestion that a degree of deference toward domestic policy choices is appropriate when scrutinizing domestic laws for compliance with international norms may be relevant in subsequent controversies.¹¹⁵

B. Private International Law

Like public international jurisprudence on intellectual property, the private international law of intellectual property also reflects both territorialist and internationalist approaches to intellectual property issues that cross international borders. In Anglo-American private international law, perhaps the best reflection of the continued importance of territoriality is in the area of subject matter jurisdiction.

In a growing body of copyright jurisprudence on subject matter jurisdiction, courts are increasingly entertaining the proposition that a domestic court should ascertain and apply foreign laws. For example, the English Court of Appeal recently rejected long-held earlier assumptions that a domestic court lacked subject matter jurisdiction over foreign copyright infringement.¹¹⁶ The Court rejected the idea that subject matter jurisdiction over foreign copyrights was barred on the basis that intellectual property rights were akin to rights in a foreign land,¹¹⁷ and that principles of international comity precluded the exercise of jurisdiction over rights so closely tied to foreign sovereignty interests.¹¹⁸ In addition, the Court considered the actionability of infringement of foreign intellectual property laws to be a permissi-

114. This issue is comprehensively explored in: Raj Bhala, *The Myth About Stare Decisis and International Trade Law (Part One of a Trilogy)*, 14 AM. U. INT'L L. REV. 845 (1999); Raj Bhala, *The Precedent Setters: De Facto Stare Decisis in WTO Adjudication (Part Two of a Trilogy)*, 9 FLA. ST. J. TRANSNAT'L L. & POL'Y 1 (1999); Raj Bhala, *The Power of the Past: Towards De Jure Stare Decisis in WTO Adjudication (Part Three of a Trilogy)*, 33 GEO. WASH. INT'L L. REV. 873 (2001).

115. An issue to be discussed further below is whether this kind of restraint is actually as supportive of the value of domestic self-determination as a willingness to expand the scope for permissible exceptions, while engaging in rigorous scrutiny of the policy aims underlying the exception, and whether or not the exception properly serves those aims. See Section II.D., *infra*.

116. *Pearce v. Ove Arup P'ship*, [1999] 1 All E.R. 769 (C.A.); cf. *Tyburn Productions v. Conan Doyle*, [1991] Ch. 75; *Atkinson Footwear v. Hodgskin Int'l Servs. Ltd.*, [1994] 31 I.P.R. 186 (H.C.) (N.Z.).

117. Cf. *Potter v. Broken Hill Proprietary Co.*, (1906) 3 C.L.R. 479 (Austl.) (holding that subject matter jurisdiction did not exist over foreign patent infringement). The *Potter* holding was extended to copyrights in *Tyburn Productions*, [1991] Ch. 75.

118. Cf. *British South Africa Co. v. Companhia de Moçambique*, [1893] A.C. 602 (H.L.); see generally Stephen Lee, *Title to Foreign Real Property in Transnational Money Claims*, 32 COLUM. J. TRANSNAT'L L. 607 (1995).

ble exception¹¹⁹ to the Anglo common law rule requiring a tort committed in a foreign territory to be shown to be wrongful according to the *lex fori* before it could be justiciable in a domestic court.¹²⁰ In line with international trends away from insistence on actionability according to the *lex fori*,¹²¹ English courts have now recognized that foreign copyrights are not so exotic as to deny their justiciability in domestic fora.¹²²

United States courts have similarly recognized that infringement of certain foreign intellectual property laws should be justiciable in domestic fora. This trend is clearest in the copyright context.¹²³ A line of recent cases has rejected the idea that infringement of foreign copyright laws is beyond the jurisdiction of domestic US courts.¹²⁴ Indeed, in one case, the Second Circuit anticipated that the district court might ascertain and apply the copyright laws of at least eighteen foreign countries.¹²⁵

Rules are available to courts and litigants to avoid unwieldy or overly burdensome litigation, such as assuming that the foreign law(s) and the law of the forum are identical.¹²⁶ In general terms, though, a

119. The relevant exception to the *lex fori* rule in foreign torts claims was first recognized by the Privy Council in *Red Sea Insurance Co. v. Bouygues S.A.*, [1995] 1 A.C. 190 (P.C.).

120. In the U.K., the *lex fori* rule has been overturned by statute: Private International Law (Miscellaneous Provisions) Act 1995 (c. 42) ("The general rule is that the applicable law is the law of the country in which the events consisting the tort or delict in question occur.").

121. See generally G.W. Austin, *The Infringement of Foreign Intellectual Property Rights*, 113 L.Q.R. 321, 323-24 (1997) (discussing the demise of the *lex fori* rule).

122. See *Pearce v. Ove Arup P'ship*, [1999] 1 All E.R. 769 (C.A.) (observing that copyright infringement is "not . . . some wrong which is conceptually unknown in English law").

123. In the patents context, for example, compare *Ortman v. Stanray Corp.*, 371 F.2d 154, 157-58 (7th Cir. 1967) (holding that jurisdiction may be exercised by a federal court over foreign patent infringement), with *Packard Instrument Co. v. Beckman Instruments, Inc.*, 346 F. Supp. 408 (N.D. Ill. 1972) (holding that court has no jurisdiction where validity of foreign patents is at issue). With respect to injunctions enjoining infringing activity outside of the jurisdiction of the forum, see *Johns Hopkins University v. Cellpro, Inc.*, 152 F.3d 1342 (Fed. Cir. 1998). For detailed analysis of the prohibitions against exercising subject matter jurisdiction over foreign patent laws, see John R. Thomas, *Litigation Beyond the Technological Frontier: Comparative Approaches to Multinational Patent Enforcement*, 27 LAW & POL'Y INT'L BUS. 277 (1996).

124. *Boosey & Hawkes Music Publishers v. Walt Disney Co.*, 145 F.3d 481 (2d Cir. 1998); *Armstrong v. Virgin Records*, 91 F. Supp. 2d 628 (S.D.N.Y. 2000); *Carrel v. Shubert Org.*, 104 F. Supp. 2d 236 (S.D.N.Y. 2000); *World Film Servs. Inc. v. RAI Radiotelevisione Italiana S.p.A.*, 1999 WL 47206 (S.D.N.Y. Feb. 3, 1999); *London Film Prods. v. Intercontinental Communications*, 580 F. Supp. 47 (S.D.N.Y. 1984).

125. *Boosey & Hawkes*, 145 F.3d 481.

126. See, e.g., *Pearce v. Ove Arup P'ship*, [1997] Ch. 293 (H.C.) (presuming similarity of Dutch and English copyright law); see generally RICHARD FENTIMAN, *FOREIGN LAW IN ENGLISH COURTS* 147-53 (1998) (discussing English courts' presumption that the content of foreign law is the same as that of English law); Ginsburg, *Cyberian Captivity*, *supra* note 6, at 356 n.23.

willingness to acknowledge foreign copyright laws evinces a significant degree of respect for foreign legal systems. Indeed, areas where domestic courts might be reluctant to entertain infringement of foreign intellectual property rights, most notably in the patent context,¹²⁷ seem to be motivated by intense solicitude towards the rights established by the laws of foreign sovereigns.¹²⁸ That is, the rights accorded by foreign sovereigns are regarded as so important to the domestic sovereignty interests of the foreign nation that the exercise of subject matter jurisdiction is rendered inappropriate.¹²⁹

127. In the English context, see JAMES J. FAWCETT & PAUL TORREMAN, *INTELLECTUAL PROPERTY AND PRIVATE INTERNATIONAL LAW* 290–93 (1998) (discussing policy limitations on the exercise of subject matter jurisdiction over infringement of foreign patent rights). Under the Brussels and Lugano Conventions, special jurisdictional rules apply for registered rights whose validity is put at issue by the infringement action. See, e.g., *Coin Controls Ltd. v. Suzo Int'l (U.K.) Ltd.*, [1997] 3 All E.R. 45 (Ch.); *Fort Dodge Animal Health Ltd v. AKZO Nobel N.V.*, [1988] F.S.R. 222. A recent analysis of these issues was provided in *Sepracor Inc. v. Hoechst Marrion Roussel Ltd.*, [1999] F.S.R. 746, 753–54, a case, litigated in a U.K. forum, involving infringement of different national designations within the European Patent Convention. The Court held that pursuant to the Brussels Convention it was not open to the plaintiff to sue in England in respect of the infringement of patents in other countries when the validity of those patents were in issue.

Art. 16(4) of the Brussels Convention provides:

The following courts shall have exclusive jurisdiction, regardless of domicile: . . . in proceedings concerned with the registration or validity of patents, trade marks, designs, or other similar rights required to be deposited or registered, the courts of the Contracting State in which the deposit or registration has been applied for, has taken place or is under the terms of an international convention deemed to have taken place.

Responding to the submission that the case should be struck out simply on the ground that it would involve the Court in adjudication of foreign patent rights, Sir Hugh Laddie responded,

Even if such a power exists, I would decline to exercise it so as to strike out the foreign claims. No doubt it is convenient and generally speaking desirable that, say, the law of Denmark should be considered and applied by Danish Courts. For that purpose the foreign court would be the *forum conveniens*. But the courts here frequently have to determine issues of foreign law. . . .

I have no doubt that one action would be quicker, cheaper and more convenient. It will reduce the possibility of conflicting decisions on the same [European Patent Convention] issues."

Sepracor, [1999] F.S.R. at 754.

128. In addition, patent laws may raise difficult practical problems, given the diversity of international patent laws, leading to fears that courts in one jurisdiction cannot properly interpret and apply the patent laws of another jurisdiction. See *supra* note 126. Professors Dreyfuss and Ginsburg consider that further analysis of the issue of jurisdiction in foreign patent claims is warranted. See Dreyfuss & Ginsburg, *supra* note 35, at 1097–98. For this reason, I do not engage with that debate in this Article.

129. For a particularly stark example, see *Plastus Kreativ AB v. Minnesota Mining and Manufacturing Co.*, [1995] R.P.C. 438, 439 ("A finding of infringement is a finding that a monopoly granted by the state is to be enforced. The result is invariably that the public have to pay higher prices than if the monopoly did not exist. If that be the proper result, then that result should, I believe, come about from a decision of a court situated in the state where the public have to pay the higher prices."). See also Laddie, *supra* note 20, at 402 (describing patent rights as a form of indirect taxation).

Ideas about the territorial character of intellectual property rights probably account for the paucity of US private international case law engaging with any kind of analysis of the government interests at stake in the choice of law analysis.¹³⁰ In US conflict of laws doctrine, government interest analysis is the occasion for most explicit analysis of the values and policies underlying substantive law principles. In the domestic context, a recent decision from within the Ninth Circuit applied government interest analysis to choice of law for the tort of misappropriation of a person's name and likeness. In *Downing v. Abercrombie & Fitch*¹³¹ the choice was between the laws of California and Hawaii, the latter providing less extensive relief than the former. The claim was based on the publication of photographs of the plaintiffs, five of whom resided in Hawaii, in a fashion catalog distributed throughout the United States, including in California. The Ninth Circuit regarded California to have a relevant interest in applying its laws, on the basis that "one of the primary purposes of creating a cause of action in tort is to deter misconduct within its borders by persons present within its borders."¹³² Hawaii did not have a countervailing interest in "restrict[ing] its residents from recovery that others could obtain in California" solely because it had not enacted an equivalent statute applicable to breaches of publicity rights occurring in the latter state.¹³³ The governmental interest analysis adopted in *Abercrombie & Fitch* seems to underscore the strong interest in having one's own (intellectual property) laws apply to activities occurring within one's own territory.

In other areas of emerging private international law doctrine touching on intellectual property issues, deference to the sovereignty interests of foreign nations in having their intellectual property laws apply to conduct occurring within their territories is less clear. In a number of contexts, US domestic courts have departed from a strictly territorial approach to intellectual property disputes involving activities in foreign nations. Some of these approaches to cross-border issues flow from common law developments, or, at least, are judicial

130. See Graeme B. Dinwoodie, *International Intellectual Property Litigation: A Vehicle for Resurgent Comparativist Thought?*, 49 AM. J. COMP. L. 429 (2001) (highlighting other explanations).

131. 265 F.3d 994 (9th Cir. 2001).

132. *Id.* at 1006. Here, the court apparently saw a direct analogy between publicity rights and traffic accidents. The court reasoned that just as a state has an interest in discouraging unsafe driving on its roads, a state also has an interest in discouraging misappropriation of personality rights within its borders.

133. *Downing*, 265 F.3d at 1007.

glosses on the statutory schemes regulating intellectual property rights. Others, particularly in the patent context, follow from legislative developments.

Perhaps the clearest example of a departure from territoriality in favor of application of domestic norms is the line of cases in which US courts have endorsed awards of damages under US copyright law for unlicensed exploitation of copyright works in foreign territories.¹³⁴ In one of the foundational cases in this area, *Sheldon v. Metro-Goldwyn Pictures*,¹³⁵ the Second Circuit seemed unperturbed by the plaintiffs' failure to plead a specific breach of the laws of the territory in which the infringing motion picture was distributed and exhibited without license: "The plaintiffs made no proof of foreign law, and we cannot say that the exhibition of the positives abroad was a tort."¹³⁶ Nevertheless, the Court endorsed the view that damages for foreign infringements were recoverable under US copyright law, as well as related principles of constructive trust.¹³⁷ A number of courts, including the Ninth Circuit, have followed suit.¹³⁸

In the trademarks context, the tendency of US courts to apply the Lanham Act to conduct abroad is well known.¹³⁹ United States Courts examine a range of factors to determine whether application of the Lanham Act to conduct in foreign territories is appropriate, including the nationality of the parties, the relative effects of the defendant's activities on commerce in the US as compared with elsewhere, whether there was an express purpose to harm US commerce, and the degree of conflict with foreign laws.¹⁴⁰ In a number of cases, courts have concluded that application of the Lanham Act to conduct

134. See *Sheldon v. Metro-Goldwyn Pictures Corp.*, 106 F.2d 45 (2d Cir. 1939), *aff'd*, 309 U.S. 390 (1940); *Update Art. Inc. v. Modiin Publ'g, Ltd.*, 843 F.2d 67 (2d Cir. 1988); *L.A. News Serv. v. Reuters Television Int'l Ltd.*, 149 F.3d 987 (9th Cir. 1998); *Gen. Motors Corp. v. Lopez de Arriorua*, 948 F. Supp 684 (E.D. Mich. 1996); *Famous Music Corp. v. Seeco Records, Inc.*, 201 F. Supp. 560, 569 (S.D.N.Y. 1961).

135. 106 F.2d 45.

136. *Sheldon*, 106 F.2d at 52.

137. *Id.* ("We need not decide whether the law of those countries where the negatives were exploited, recognized the plaintiffs' equitable interest; we can assume arguingo that it did not, for, as soon as any of the profits so realized took the form of property whose situs was in the United States, our law seized upon them and impressed them with a constructive trust, whatever their form.")

138. *L.A. News Serv.*, 149 F.3d 987.

139. See, e.g., *Steele v. Bulova Watch Co.*, 344 U.S. 280 (1952); *Fun-Damental Too, Ltd. v. Gemmy Indus. Corp.*, 111 F.3d 993 (2d Cir. 1997); *Ocean Garden, Inc. v. Marktrade Co., Inc.*, 953 F.2d 500 (9th Cir. 1991); cf. *Totalplan Corp. of Am. v. Colborne*, 14 F.3d 824 (2d Cir. 1994); *Vanity Fair Mills, Inc. v. T. Eaton Co.*, 234 F.2d 633 (2d Cir. 1956).

140. *Vanity Fair Mills*, 234 F.2d at 642.

abroad is consistent with the constitutional principle of the regulation of US commerce.¹⁴¹

Somewhat consistent with this trend are cases in which causes of action that have significant foreign elements have been localized in the United States. A recent example of this was in *National Football League v. Primetime 24 Joint Venture*,¹⁴² which found infringement under US law for re-broadcasting television programs, where the ultimate audience for the programs was in Canada. The steps on the way to reaching the Canadian audience, such as the unauthorized capture and initial transmissions of the broadcasts, were sufficient to implicate US law.¹⁴³

Transnational cases involving patents and unfair competition principles also provide examples of liability theories that depart from a strictly territorialist perspective. While patents are generally regarded as strictly territorial,¹⁴⁴ statutory initiatives have made it an infringement of US patent law to supply in or from the United States the components of a patented invention in a manner that facilitates the working of the invention in a foreign territory.¹⁴⁵ In the unfair competition context, some courts have read international law norms (spelt out of article 10 of the Paris Convention) into the Lanham Act, suggesting that domestic courts might have recourse to “suprana-

141. See, e.g., *Atlantic Richfield Co. v. ARCO Globus Int'l Co.*, 150 F.3d 189 (2d Cir. 1998); *Ocean Garden*, 953 F.2d 500.

142. 211 F.3d 10 (2d Cir. 2000).

143. See also William Patry, *Choice of Law and International Copyright*, 48 AM. J. COMP. L. 383, 460–67 (2000) (discussing liability theories relevant to the *Primetime 24* litigation).

144. *Deepsouth Packing Co. v. Laitram Corp.*, 406 U.S. 518 (1972).

145. 35 U.S.C. § 271(f), enacted specifically to override the Supreme Court's holding in *Deepsouth Packing Co.*, 406 U.S. 518 (1972), provides:

(1) Whoever without authority supplies or causes to be supplied in or from the United States all or a substantial portion of the components of a patented invention, where such components are uncombined in whole or in part, in such manner as to actively induce the combination of such components outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.

(2) Whoever without authority supplies or causes to be supplied in or from the United States any component of a patented invention that is especially made or especially adapted for use in the invention and not a staple article or commodity of commerce suitable for substantial noninfringing use, where such component is uncombined in whole or in part, knowing that such component is so made or adapted and intending that such component will be combined outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.

35 U.S.C. § 271(f) (2002).

tional" legal norms in domestic cases that have significant international elements.¹⁴⁶

One of the most interesting US cases in this area concerned the extent to which injunctive relief granted under the authority of the Lanham Act could reach conduct abroad that had effects in the United States. In *Sterling Drug, Inc. v. Bayer AG*, the District Court for the Southern District of New York granted an injunction against the German Bayer firm, precluding it from using the Bayer trademark, of which it was the proprietor in many other foreign countries, in a manner that caused confusion in the United States with Sterling's US Bayer trademark.¹⁴⁷ The Second Circuit was thus required to engage with the tension between Bayer's right to use the Bayer mark in foreign markets and the deleterious effects that such use might have on Sterling's legitimate use of the same mark in US-based commerce.¹⁴⁸ The breadth of the injunction granted in the lower court, whose prohibitions included enjoining the use of the "Bayer" name or mark "in . . . any employment notice . . . published or reasonably likely to be distributed within the United States,"¹⁴⁹ prompted the German company (and, indeed, the German government)¹⁵⁰ to complain that the "extraterritorial injunctive provisions impair the ability of one of Europe's largest corporations to conduct its everyday business in its home country and around the world."¹⁵¹

There is a strong strand of territorialist thinking in the Second Circuit's observation that "[t]hrough Congress did not intend the Lanham Act to be used as a sword to eviscerate completely a foreign corporation's foreign trademark, it did intend the Act to be used as a shield against foreign uses that have significant trademark-impairing effects upon American commerce."¹⁵² Nevertheless, the Court also recognized that significant issues were at stake when "the holder of rights in a mark under German law [is] ordered by a United States

146. *Gen. Motors Corp. v. Lopez de Arriortua*, 948 F. Supp 684 (E.D. Mich. 1996) (holding that the Lanham Act, by incorporating the substantive provisions of the Paris Convention, creates a federal law of unfair competition).

147. 792 F. Supp. 1357 (S.D.N.Y. 1992).

148. *Sterling Drug, Inc. v. Bayer AG*, 14 F.3d 733 (2d Cir. 1994).

149. *Id.* at 745.

150. The German government appeared as an *amicus*, concerned that the scope of the injunction granted by the US district court impinged inappropriately on German sovereignty interests. *Id.* at 744.

151. *Id.* at 745.

152. *Id.* at 746.

court to refrain from uses of that mark protected by German law,¹⁵³ and invited the District Court to reconsider the extraterritorial scope of the injunction. Thus, although a territorial focus was manifest in parts of its analysis, in other respects, the Court was sensitive to the international character of the dispute. The District Court was asked to consider whether it should amend its original injunction in order to better “balance . . . the equities to reach an *appropriate* result protective of the interests of both parties.”¹⁵⁴ The Second Circuit also suggested that “an appropriately limited injunction” would include “only those extraterritorial provisions reasonably necessary to protect against *significant* trademark-impairing effects on United States commerce.”¹⁵⁵

The “significant” effects standard¹⁵⁶ also implied that the basis for exercising jurisdiction under the Lanham Act dictated the scope of relief that might be afforded US trademark proprietors in international cases of this kind. Hence, the *Bayer* court can be seen to be actively engaged in forging substantive standards for an environment in which it has become inevitable that trademark use that might be legitimate in one territory will bump up against other, equally legitimate, rights of other parties in other territories.¹⁵⁷

II. THE DEVELOPMENT OF INTERNATIONAL INTELLECTUAL PROPERTY JURISPRUDENCE

The approach of the *Bayer* court toward fashioning an appropriate remedy in the light of the international and domestic contexts anticipates, and underscores the importance of, Professor Dinwoodie’s recent scholarship advocating a choice of law approach that would require domestic courts to engage more directly with international intellectual property values and policies in the shaping of international intellectual property jurisprudence.¹⁵⁸ In private interna-

153. *Id.* at 747.

154. *Id.* (quoting *Soltex Polymer Corp. v. Fortex Indus., Inc.*, 832 F.2d 1325, 1330 (2d Cir. 1987)).

155. *Id.* (emphasis added).

156. *Cf.* Lanham Act § 43(a), 15 U.S.C. § 1125 (2001) (imposing a “likelihood of confusion” standard for infringement of trademark rights).

157. *See also* *Buti v. Impresa Perosa S.A.*, 139 F.3d 98 (2d Cir. 1998) (testing whether trademark use by a foreign entity in the United States was sufficient to “substantially affect” US commerce); *see generally* Dan L. Burk, *Trademark Doctrines for Global Electronic Commerce*, 49 S.C. L. REV. 695 (1998).

158. *See* Dinwoodie, *supra* note 31; Dinwoodie, *supra* note 34.

tional intellectual property law, Professor Dinwoodie seeks to displace both the strictly territorialist approach to transborder disputes as well as some of the "localizing" techniques adopted by US courts.¹⁵⁹ Instead, courts seized of transnational disputes would "consider whether the international dimension implicated policies of other states or the international copyright system, and develop (and apply) a substantive rule of copyright law that best effectuates this range of policies."¹⁶⁰

Professor Dinwoodie suggests that the sources of law to which courts should have recourse when developing these substantive rules might include international agreements and practices, national and regional laws, developing post-national groupings, and conflicts values.¹⁶¹ From these, and possibly other, sources, courts would distill substantive law responses that, while perhaps not recognizable according to any one of the domestic laws potentially implicated,¹⁶² would be informed by judicial engagement with the values underlying all of them.

At the public international law level, the emergence of supranational intellectual property law regimes, and the inevitability of their continued development and promotion, has prompted debate about the kinds of values that ought to inform the development of this body of law, the processes by which intellectual property values might be identified, articulated and developed, and the parties and institutions that should be involved in these processes.¹⁶³ In turn, these concerns prompt inquiry into whether intellectual property values can be identified that can guide the continuing formulation of modern international intellectual property law. It may be, however, that the search for intellectual property values that will assist in the construction of intellectual property values will prove illusory. Instead, it may be more productive to consider intellectual property values as part of a broader set of legal policy issues that are relevant to the organization of domestic states: policy issues that will likely be resolved in a

159. See, e.g., *NFL v. Primetime 24 Joint Venture*, 211 F.3d 10 (2d Cir. 2000) (copyright); *Ocean Garden, Inc. v. Marktrade Co.*, 953 F.2d 500 (9th Cir. 1991) (trademark); *Atlantic Richfield Co. v. Arco Globus Int'l Co.*, 150 F.3d 189 (2d Cir. 1998) (trademark).

160. Dinwoodie, *supra* note 34, at 543 (footnote omitted).

161. *Id.* at 552.

162. *Id.* at 558–69 (suggesting courts adopt "compromise solutions" where two potentially applicable laws offer disparate solutions to transborder copyright issues).

163. See generally Dinwoodie, *supra* note 34; Helfer & Dinwoodie, *supra* note 34.

diverse range of ways, depending on individual nations' political, cultural, and economic circumstances.¹⁶⁴

A. *Intellectual Property Values*

In public international law, concern for the values that intellectual property laws are meant to serve might inform the content of the documents that are promulgated by international lawmaking bodies. In addition, identification of intellectual property law values may guide the interpretation of international intellectual property law instruments. For instance, in the WTO panel decision regarding section 110(5) of the US Copyright Act, some aspects of the interpretive task that faced the panel involved more or less objective questions of construction, such as determining whether the "minor exceptions" doctrine may be applied to even to those rights, such as broadcasting and communication to the public,¹⁶⁵ for which the Berne Convention makes no express provision for exemptions.¹⁶⁶ However, other aspects of the WTO Panel's interpretive task had the potential at least to be rather less objective, including the tasks of determining what comprises a "normal exploitation of the work,"¹⁶⁷ or what exemptions might "unreasonably prejudice the legitimate interests of the right holder."¹⁶⁸

Numerous questions requiring value judgments might arise in future cases where analysis of the issue of compliance with, and thereby the interpretation of, international law instruments is raised. For instance, in the computer software context, it is clear that failure to protect computer programs in object code as copyright works under the terms of the Berne Convention would be a clear breach of article 10 of TRIPs.¹⁶⁹ But other issues might be less easily resolved. What if

164. See generally *Integrating Intellectual Property Rights*, *supra* note 25.

165. Panel Report, *supra* note 65, at ¶¶ 6.47–6.66 (concluding that the minor exceptions doctrine was included by implication in articles 11 and 11*bis* of the Berne Convention, and that the minor exception doctrine was incorporated into the TRIPs agreement by article 9.1 of the latter document).

166. Berne Convention, *supra* note 11. Article 9.2 of the Berne Convention expressly provides for exceptions for the reproduction right. No express provision for exceptions is made with respect to other relevant rights, including the rights of public performance, communication to the public (art. 11) or broadcasting (art. 11*bis*).

167. TRIPs, *supra* note 11, art. 13.

168. *Id.*

169. *Id.* art. 10.1 ("Computer programs, whether in source or object code, shall be protected as literary works under the Berne Convention (1971).").

it is thought that the "abstraction—filtration—comparison" test¹⁷⁰ that is adopted by some US courts for determining the degree of protection for computer software is too vigorously applied, leaving too little scope for protection?¹⁷¹ What of a legal system that sets a high bar for qualification of a work as a derivative work¹⁷²—or which renders states within a federal system immune from suit for patent infringement?¹⁷³

Likewise, in the trademarks context, what are the parameters of the defense for "fair use of descriptive terms," a defense whose uncertain scope seems little clarified by the requirement that "account [be taken] of the legitimate interests of the owner of the trademark and of third parties"?¹⁷⁴ Or, with respect to patents, what "interests of third parties" need be taken into account for the purposes of the construction and application of article 30 of TRIPs?¹⁷⁵

In the private international law context also, international intellectual property law values might inform courts' decisions in a variety of contexts. Analysis of intellectual property law values might be appropriate when courts are asked to develop new doctrine, particularly in contexts, such as in the *Bayer* litigation,¹⁷⁶ where the interests of domestic and foreign proprietors of intellectual property might clash, or where there is potential tension between the extraterritorial

170. See *Computer Assocs. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 706 (2d Cir. 1992); see generally Julian Velasco, Note, *The Copyrightability of Nonliteral Elements of Computer Programs*, 94 COLUM. L. REV. 242 (1994).

171. Austin, *supra* note 20, at 608–10 (discussing different international approaches toward the "filtering" out of unprotected material in computer software infringement actions). For a US approach that differs from that adopted by the *Altai* court, see *Apple Computer, Inc. v. Microsoft Corp.*, 779 F. Supp. 133 (N.D. Cal. 1991).

172. See, e.g., *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 489 (2d Cir. 1976) (en banc) (requiring that a work based on an earlier public domain work exhibit "elements of difference that amounted to a significant alteration"); *Gracen v. Bradford Exch.*, 698 F.2d 300, 305 (7th Cir. 1983) (requiring a "sufficiently gross difference between the underlying and the derivative work"). For rigorous critique of this line of cases, see Robert A. Gorman, *Copyright Courts and Aesthetic Judgments: Abuse or Necessity?*, 25 COLUM.-VLA J.L. & ARTS (forthcoming 2002).

173. See *Coll. Sav. Bank v. Fla. Prepaid Postsecondary Educ. Expense Bd.*, 527 U.S. 666 (1999); *Fla. Educ. Expense Bd. v. Coll. Sav. Bank*, 527 U.S. 627 (1999); see generally Mitchell N. Berman et al., *State Accountability for Violations of Intellectual Property Rights: How to "Fix" Florida Prepaid (And How Not To)*, 79 TEX. L. REV. 1037 (2001).

174. TRIPs, *supra* note 11, art. 17 ("Members may provide limited exceptions to the rights conferred by a trademark, such as fair use of descriptive terms, provided that such exceptions take account of the legitimate interests of the owner of the trademark and of third parties.")

175. *Id.* art. 30 ("Members may provide limited exceptions to the exclusive rights conferred by a patent, provided that such exceptions do not unreasonably conflict with a normal exploitation of the patent and do not unreasonably prejudice the legitimate interests of the patent owners, taking account of the legitimate interests of third parties.")

176. See *supra* note 147–57 and accompanying text.

application of domestic laws and foreign sovereignty interests.¹⁷⁷ As I have argued elsewhere,¹⁷⁸ decisions about whether to localize an infringement within the forum, or to apply a single governing law to a dispute, rather than the laws of the various countries in which infringements take place, may be characterized as issues of social policy, whose analysis may usefully be informed by consideration of the values that might be served by adopting one or other of the choices available to a forum seized of a transnational dispute. And if Professor Dinwoodie's suggestion that courts develop a substantive law approach to choice of law in transnational intellectual property disputes takes hold,¹⁷⁹ there would be considerable scope for courts to engage with scrutiny of underlying values and policies of the different domestic rules that may be in conflict.

But is it really possible to identify discrete intellectual property values? Some commentators have implied as much, when they have argued that the internationalization of intellectual property is usurping the values that underlie discrete bodies of domestic intellectual property law. These concerns have been expressed most passionately in the copyright law context. Writing in 1995, shortly after the passage of the Uruguay Round Agreements Act,¹⁸⁰ David Nimmer prophesized that US copyright law was about to be transformed into an instrumentality for serving the interests of international trade, rather than the goals of domestic copyright law.¹⁸¹ Professor Nimmer was concerned that the goals of copyright law were about to be usurped by other, external agenda, which would override the careful checks and balances articulated in the copyright statutes and the case law they generated.¹⁸² Professor Nimmer suggested that, post-TRIPS, US copyright could no longer be regarded as "rooted in the Copyright Clause of the Constitution."¹⁸³ This theme has been continued by other commentators, including Professor Crews, who suggests that harmonization of laws "has brought distinct change to US law in ways

177. See generally Bradley, *supra* note 10.

178. Austin, *supra* note 20.

179. Dinwoodie, *supra* note 34.

180. Uruguay Round Agreements Act, Pub. L. 103-465, 108 Stat. 4809, 4833-34 (1994).

181. David Nimmer, *The End of Copyright*, 48 VAND. L. REV. 1385 (1995).

182. For discussion of similar concerns expressed in the English context, where intellectual property commentators have complained that the "purity" of Anglo copyright law has been tainted by European Directives, see David Vaver, *The Copyright Mixture in a Mixed Legal System: Fit for Human Consumption?*, 5.2 ELECTRONIC J. COMP. L. (2001), at <http://www.ejcl.org/ejcl/52/art52-3.html>.

183. Nimmer, *supra* note 181, at 1412.

contrary to the fundamental purposes of copyright law and its social objectives."¹⁸⁴

The concern that core intellectual property law values risk being usurped by the continuing emergence of supranational norms, particularly those norms that are generated in the international trade context, might be more compelling were it possible to identify with precision what the policies are that intellectual property laws are meant to serve. In some contexts, the policies underlying legislative initiatives may be quite obvious. I discuss below, for instance, a recent legislative innovation in New Zealand trademark law that is designed to address some of the constitutional challenges that have been brought by a number of Maori tribes in the intellectual property context.¹⁸⁵ In other contexts, identifying "core" intellectual property values might be quite difficult, however, particularly in cases of doctrinal uncertainty.

In US law, an obvious source for core intellectual property values are the constitutional clauses that provide the foundation for the key federal schemes. However, the constitutional edicts concerning the regulation of commerce¹⁸⁶ and promoting the progress of science and useful arts¹⁸⁷ are probably insufficient to tell us how to resolve the innumerable policy issues that arise almost on a daily basis in modern intellectual property law. Of course, some broad principles might be identified, such as the idea that "creative people ought to get paid"¹⁸⁸—but this does not tell us how much they should be paid¹⁸⁹ or exactly what they should be paid for, nor does it help identify what countervailing principles might temper even this apparent truism. What are the *intellectual property* values that tell us how to strike an appropriate balance between freedom of contract and fair use rights,¹⁹⁰ for instance, or between the policies promoted by the Lan-

184. Kenneth D. Crews, *Harmonization and the Goals of Copyright: Property Rights or Cultural Progress?*, 6 IND. J. GLOBAL LEGAL STUD. 117, 118 (1998).

185. See *infra* notes 227–39 and accompanying text.

186. U.S. CONST. art. I, § 8, cl. 3.

187. *Id.* art. I, § 8, cl. 8.

188. This proposition was recognized by the Supreme Court in *Mazer v. Stein*, 347 U.S. 201, 219 (1954), where the Court held: "Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered."

189. Jane C. Ginsburg, "The Exclusive Right to Their Writings": *Copyright Versus Control in the Digital Age*, 7 N.Z. BUS. L.Q. 136, 140 (2001).

190. *ProCD, Inc. v. Zeidenberg*, 86 F.3d 1447 (7th Cir. 1996) (concluding that a shrinkwrap license that expands the scope of protection afforded by copyright law survives federal pre-emption). For a contrary view, where a contract was reached without bargaining, see *Info. Handling Services, Inc. v. LRP Publications, Inc.*, 54 U.S.P.Q.2d 1571 (E.D. Pa. 2000). See

ham Act and those promoted by copyright law,¹⁹¹ or between “author-focused” and “efficient-dissemination-focused” approaches to interpretation of privileges afforded by the copyright statute?¹⁹² These, and innumerable other topics, raise issues on which reasonable people are likely to continue to disagree. Constitutional foundations provide only vague guidance as to their resolution. Given the dynamic nature of intellectual property lawmaking and the diversity of interests that seek representation in the process,¹⁹³ it may often be very unclear what the intellectual property policies *are* that risk being overridden by trade policies, as intellectual property laws continue to internationalize.

And, even if specific intellectual property values can be identified, they are quite likely to change over time. In the US copyright context, for instance, the current era might be described as one that valorizes private property interests protected by intellectual property law over the idea that society’s interests should dictate the extent of private monopolies.¹⁹⁴ Some commentators contrast this with the policies that dominated in earlier times, where the rights of intellectual property proprietors were part of a bargain with society: rights were afforded to authors only if, and only to the extent that, such rights served the public good.¹⁹⁵ But observations about the dominant ideas underlying intellectual property law in the current era are insufficient to dictate the outcomes of difficult policy issues that will arise as intellectual property law continues to develop on the interna-

generally Maureen A. O’Rourke, *Copyright Preemption After the ProCD Case: A Market-Based Approach*, 12 BERKELEY TECH. L.J. 53 (1997) (generally supporting the *Pro-CD* approach where contractual terms at variance with copyright norms are conspicuous).

191. *Comedy III Prods., Inc. v. New Line Cinema*, 200 F.3d 593, 595 (9th Cir. 2000) (“If material covered by copyright law has passed into the public domain, it cannot then be protected by the Lanham Act without rendering the Copyright Act a nullity.”).

192. In *New York Times v. Tasini*, 533 U.S. 483 (2001), involving the scope of the privilege afforded under 17 U.S.C. § 201(c) to proprietors of a copyright in a “collective work” to reproduce and distribute “any revision of that collective work,” Justice Stevens, writing for the dissent, characterized the approach of the Court, which held that the privilege did not extend to dissemination of electronic versions of individual articles, as subverting the “fundamental goal of copyright law in favor of a narrow focus on ‘authorial rights.’” *Id.* at 520.

193. For detailed discussion of the lobbying efforts of the various factions that contributed to the shape of US copyright law, see JESSICA LITMAN, *DIGITAL COPYRIGHT* 35–69 (2001).

194. For a stark example of this perspective finding expression in copyright litigation, see *UMG Recordings, Inc. v. MP3.COM, Inc.*, 92 F. Supp. 2d 349, 352 (S.D.N.Y. 2000) (“Copyright . . . is not designed to afford consumer protection or convenience but, rather, to protect the copyright holders’ property interests.”).

195. See LITMAN, *supra* note 193, at 77–88. For a contrasting view, see Jane C. Ginsburg, *Copyright and Control over New Technologies of Dissemination*, 101 COLUM. L. REV. 1613 (2001).

tional scene.¹⁹⁶ As Professor Ginsburg has so compellingly established in the copyright context, a range of policy concerns, foundational principles, and values has informed copyright law from its beginnings.¹⁹⁷ This suggests that courts and policymakers in the US tradition are able to tap a fairly extensive and diverse justificatory repertoire when formulating resolutions to the innumerable issues that arise as copyright law continues to be forged and disputes resolved.

More fundamentally, to focus on *intellectual property* values may be to focus on the wrong set of issues. However venerable and however much the intellectual property community may be interested in them, intellectual property policies are not—or, I suggest, should not be regarded as—ends in themselves. To the extent that intellectual property policies and values can be identified, it might be more helpful to regard them as aspects of much broader issues of public policy. Policies that help ensure that populations get fed, enjoy the benefits of literacy, are healthy, have viable agricultural bases, and can participate in technological and cultural development¹⁹⁸—these seem to be the kinds of policies that should have priority in any analysis of the values that intellectual property laws are meant to serve.

Intellectual property rights impact upon the public¹⁹⁹ administration of individual states in a range of contexts: technological,²⁰⁰ cultural,²⁰¹ medical,²⁰² agrarian,²⁰³ political,²⁰⁴ and may impact significantly

196. See Austin, *Isolationism*, *supra* note 21.

197. For an historical perspective on this issue, see Jane C. Ginsburg, *A Tale of Two Copyrights: Literary Property in Revolutionary France and America*, 64 TUL. L. REV. 991 (1990); see also Ginsburg, *supra* note 189.

198. Ensuring that a country enjoys peaceable race relations may also raise important intellectual property issues: see the discussion of the New Zealand Trade Marks Bill 2001, *infra* notes 227–39 and accompanying text.

199. Some commentators have identified tension between the role of intellectual property rights in the public administration of the state and their characterization as “private” rights. See, e.g., TRIPs, *supra* note 11, at pmb1. (stating that “intellectual property rights are ‘private’ rights,” while at the same time “recognizing the underlying public policy objectives of national systems for the protection of intellectual property, including developmental and technological objectives”). Drawing on the work of Legal Realists, Professor Aoki has discussed in detail the tension between the asserted privacy of intellectual property rights and the state mechanisms that are required to create and enforce them. See Aoki, *supra* note 9, at 449–53.

200. In patent law, this is virtually a truism. But see Peter Drahos, *Biotechnology Patents, Markets and Morality*, 21 EUR. INTEL. PROP. REV. 441, 442–45 (1999) (suggesting that governments have increased the number of patents granted without considering the “broader public ethic”).

201. Consider, for example, the comments of former Register of Copyrights on the cultural importance of copyright law: “Though their true influence is dimly understood at best, a nation’s copyright laws lie at the roots of its culture and intellectual climate. Copyright provides the inducement for creation and dissemination of the works that shape our society and, in an

on marketplace morality.²⁰⁵ Different nations will face different challenges with respect to each of these and other policy concerns for which intellectual property rights might be relevant. The connections between intellectual property rights, important issues of public policy, and the reality of diversity in the individual nations' domestic circumstances would seem to support the continued viability and relevance of the territoriality principle, even as that principle is coming under increasing pressure to yield. And it is the inevitability of differences in the circumstances of different nations—social, economic, political, even climatic differences—that suggests that deference to domestic law choices as to how to shape intellectual property laws should itself be regarded as a key value that ought to inform the construction of international intellectual property jurisprudence.

B. *Experimentation in Domestic Intellectual Property Law*

In important respects, the value of domestic self-determination is already reflected in the degree of experimentation that occurs in crafting national or regional intellectual property laws. Self-conscious experimentation—trying out ideas in order to accommodate domestic circumstances—occurs in a range of domestic intellectual property law contexts.²⁰⁶ An obvious benefit of encouraging domestic experi-

imperfect and almost accidental way, represents one of the foundations upon which freedom of expression rests." Barbara A. Ringer, *The Role of the United States in International Copyright—Past, Present, and Future*, 56 GEO. L.J. 1050, 1050 (1968).

202. See, e.g., John Robinson Thomas, *New Challenges for the Law of Patents*, in INTERNATIONAL INTELLECTUAL PROPERTY AND THE COMMON LAW WORLD 165–66 (Charles E.F. Rickett & Graeme W. Austin eds., 2000); Arti K. Rai, *Fostering Cumulative Innovation in the Biopharmaceutical Industry: The Role of Patents and Antitrust*, 16 BERKELEY TECH. L.J. 813 (2001).

203. See generally DANIEL CHARLES, *LORDS OF THE HARVEST* (2001); JACK RALPH KLOPPENBURG, JR., *FIRST THE SEED: THE POLITICAL ECONOMY OF PLANT BIOTECHNOLOGY, 1492–2000* (1988).

204. See, e.g., Neil Weinstock Netanel, *Copyright and a Democratic Civil Society*, 106 YALE L.J. 283, 288 (1996); Neil Weinstock Netanel, *Asserting Copyright's Democratic Principles in the Global Arena*, 51 VAND. L. REV. 217 (1998) (identifying the furtherance of democratic principles as a central purpose of copyright law and arguing that the internationalization of copyright law, in itself, will not necessarily contribute to the further development of copyright's democracy constitutive potential).

205. Daniel M. McClure, *Trademarks and Competition: The Recent History*, LAW & CONTEMP. PROBS., Spring 1996, at 13, 32 (describing the promotion of marketplace morality as one of the purposes of trademark law).

206. There are connections here with theories of regulatory competition in the US federal context, developed particularly in the area of competition for incorporations. For detailed analysis (and rigorous critique) of these theories, see Ehud Kamar, *A Regulatory Competition Theory of Indeterminacy in Corporate Law*, 98 COLUM. L. REV. 1908 (1998). These issues are explored in the cyberspace context in Dan L. Burk, *Virtual Exit in the Global Information*

mentation in crafting intellectual property laws is that domestic nations (or quasi-federal units, such as the European Community) can serve as laboratories for testing intellectual property initiatives.²⁰⁷ For the US, laws enacted in compliance with the European Database Directive might provide an example. For various reasons, enactment of *sui generis* database legislation in the US has stalled.²⁰⁸ If the idea that US database legislation be enacted is revived,²⁰⁹ the experience in Europe will now provide US lawmakers with important information as to the viability of one model for database legislation.²¹⁰ There is now a body of case law arising under the laws of individual European nations that have enacted laws in compliance with the Directive²¹¹ that may provide helpful guidance for US judges if they are required to engage with broader policy issues under any US database law.

The United States' own Digital Millennium Copyright Act ("DMCA") is itself providing an important resource for other jurisdictions, as they consider how best to craft copyright laws to meet the challenges of the digital environment.²¹² The DMCA and its foreign equivalents are experimental simply for the reason that they are new additions to copyright law that are focused on new technologies whose future development is unpredictable. Indeed, the DMCA has been described as "avowedly experimental," even within purely domestic law terms.²¹³ As Professor Bill Cornish points out, the experimental character of the DMCA is manifest in the built-in early

Economy, 73 CHI.-KENT L. REV. 943 (1998).

207. Cf. Michael W. McConnell, *Federalism: Evaluating the Founders' Design*, 54 U. CHI. L. REV. 1484, 1497-99 (1987) (book review) (making this argument in the US federalist context).

208. See generally Marci A. Hamilton, *Database Protection and the Circuitous Route Around the United States Constitution*, in INTERNATIONAL INTELLECTUAL PROPERTY AND THE COMMON LAW WORLD, *supra* note 202, at 9; Michael Freno, Note, *Database Protection: Resolving the U.S. Database Dilemma with an Eye Toward International Protection*, 34 CORNELL INT'L L.J. 165 (2001).

209. See *Transcript of Press Conference of Rep. Billy Tauzin (R-LA) and Rep. James Sensenbrenner (R-WI)*, TECH L.J., Mar. 29, 2000, at <http://www.techlawjournal.com/cong107/database/20010329.asp> (discussing the possibility of introducing database legislation into Congress).

210. See generally Stephen M. Maurer et al., *Europe's Database Experiment*, 294 SCIENCE, Oct. 26, 2001, at 789.

211. See, e.g., *British Horseracing Bd. Ltd. v. William Hill Org. Ltd.*, CHAN/2001/0632/A3 [2001] E.W.C.A. Civ. 1268, July 31, 2001; see also Maurer et al., *supra* note 210.

212. See, e.g., INTELLECTUAL PROP. DIRECTORATE INDUS. CAN., CONSULTATION PAPER ON DIGITAL COPYRIGHT ISSUES (2001) (Canada); MINISTRY OF ECON. DEV. MANATU OHANGA, DIGITAL TECHNOLOGY AND THE COPYRIGHT ACT 1994—A DISCUSSION PAPER (2001) (New Zealand).

213. William Cornish, Introductory Comments delivered at the 2001 ALAI Congress, at Columbia University June 2001, available at http://www.law.columbia.edu/conferences/2001/1_program_en.htm

reviews of its own operation.²¹⁴ Through this process, it might be discovered that the anti-circumvention measures and other aspects of the DMCA were an excellent experiment, an outcome that might encourage more nations to adopt them. On the other hand, it is possible that they may be regarded as having unfortunate consequences, possibly even prompting them to be rethought.²¹⁵

A second sense in which it is appropriate to characterize intellectual property laws as experimental has to do with the relationship between intellectual property law and other legal institutions. Referring to copyright law's relationship with contract, the Copyright Office has recently noted that, in the US context, movements at the state level towards removing impediments to enforcement of non-negotiated license agreements and the technical protection measures that are legally enforced by the DMCA may mean that rights holders, rather than Congress, will increasingly come to "determine the landscape of consumer privileges in the future."²¹⁶ While the Copyright Office decided that the issue of preemption of contractual provisions was beyond the scope of its recent section 104 report,²¹⁷ it also acknowledged the importance and complexity of the issue.²¹⁸ Characterizing copyright law as providing a background of default provisions against which parties are generally free to order their own commercial dealings to suit their needs and the realities of the marketplace, the Copyright Office nevertheless recognized that if "consumer privileges" become unreasonably prejudiced a case could be made for statutory change.²¹⁹

Likewise, the relationship between intellectual property law and competition law has recently occupied the attention of a number of

214. *Id.*; see Exemption to Prohibition on Circumvention of Copyright Protection Systems for Access Control Technologies: Final Rule, 65 Fed. Reg. 64,555 (Oct. 27, 2000) (to be codified at 37 C.F.R. pt. 201).

215. A "wait and see" approach to the issue of whether the DMCA is overreaching appears to be currently adopted by courts. See, for example, Judge Kaplan's discussion in *Universal City Studios, Inc. v. Reimerdes*, 111 F. Supp. 2d 294 (S.D.N.Y. 2000), *aff'd*, *Universal City Studios, Inc. v. Corley*, 273 F.3d 429 (2d Cir. 2001), of whether the methods of encryption that are bolstered legally by the DMCA would preclude access to public domain works. Judge Kaplan noted that this "does not yet appear to be a problem, although it may emerge as one in the future." *Id.* at 338 n.245. The Second Circuit cited this observation with approval in *Universal City Studios, Inc. v. Corley*. Presumably, if a serious problem of "locking up" public domain works is identified, some further analysis of the scope of the DMCA might be appropriate.

216. U.S. COPYRIGHT OFFICE, DMCA SECTION 104 REPORT 164, available at <http://www.loc.gov/copyright/reports/studies/dmca/sec-104-report-vol-1.pdf> (2001).

217. *Id.* at 163.

218. *Id.* at 164.

219. *Id.*

commentators,²²⁰ courts,²²¹ and policymakers.²²² For instance, the recently promulgated report²²³ from the U.K. Office of Fair Trading on the application of the U.K. Competition Act 1998 to agreements and conduct which concern intellectual property rights identifies a number of contexts in which intellectual property proprietors' control over the exploitation of their rights may need to give way to competition law policies.²²⁴

Some intellectual property experiments pursued by domestic nations are unlikely to implicate public international law obligations because they offer standards that are *more* protective than international law norms. International intellectual property treaties generally set minimum standards—they do not impose a ceiling on the level of protection domestic nations may afford to intellectual property holders.²²⁵ Indeed, the ability of domestic nations to provide greater protection is often specifically provided for in public international law instruments.²²⁶

Other kinds of domestic law experiments may have a less comfortable existence in the spotlight of public international law norms,

220. See generally Ian Eagles, *Intellectual Property and Competition Policy: The Case for Neutrality*, in INTERNATIONAL INTELLECTUAL PROPERTY AND THE COMMON LAW WORLD, *supra* note 202, at 285; Sergio Baches Opi, *The Application of the Essential Facilities Doctrine to Intellectual Property Licensing in the European Union and the United States: Are Intellectual Property Rights Still Sacrosanct?*, 11 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 409 (2001); Robert Pitofsky, *Challenges of the New Economy: Issues at the Intersection of Antitrust and Intellectual Property*, 68 ANTITRUST L.J. 913 (2001).

221. See, e.g., *Radio Telefis Eirean and Indep. Television Publ'ns Ltd. v. E.C. Comm'n* [1995] 4 C.M.L.R. 718 (holding that copyright is subject to EU prohibitions against misuse of monopoly powers); *Noll v. O.M. Scott & Sons Co.*, 467 F.2d 295, 301 (6th Cir. 1972) (misuse of patent rights doctrine); *DSC Communications v. DGI Techs.*, 81 F.3d 597 (5th Cir. 1996) (misuse of copyright).

222. See, e.g., U.K. OFFICE OF FAIR TRADING, INTELLECTUAL PROPERTY RIGHTS—A DRAFT COMPETITION ACT 1998 GUIDELINE, available at http://www.oft.gov.uk/html/compact/technical_guidelines/oft418.html (2001) (discussing the relationship between intellectual property rights and competition law policy).

223. See *id.*

224. For instance, refusal to license an intellectual property right might be regarded as abuse of a dominant position in some circumstances. *Id.* ¶ 3.7.

225. See e.g., North American Free Trade Agreement, Dec. 8–17, 1992, 32 I.L.M. 289, art. 1702 (“A Party may implement in its domestic law more extensive protection of intellectual property rights than is required under this Agreement, provided that such protection is not inconsistent with this Agreement.”); Berne Convention, *supra* note 11, art. 19 (“The provisions of this Convention shall not preclude the making of a claim to the benefit of any greater protection which may be granted by legislation in a country of the Union.”); TRIPs *supra* note 11, art. 1.

226. This is the case with some parts of the anti-circumvention provisions in the DMCA, for instance, which go beyond the requirements of the 1996 WIPO Copyright Treaty, with which it sought to comply. See *supra* note 71.

however. Another example from New Zealand may help to illustrate the point. Claimants from a number of Maori iwi (tribes) have brought a claim against the Crown entitled, "The Indigenous Flora and Fauna and Maori Intellectual and Cultural Property Claim" or "WAI 262."²²⁷ The forum is the Waitangi Tribunal, a statutory quasi-judicial body whose purpose is to investigate grievances by Maori against the Crown that allege breaches of the Crown's obligations under the Treaty of Waitangi, a treaty that guarantees Maori, *inter alia*, "te tino rangatiratanga" ("full chieftainship") over "taonga" ("treasured possessions").²²⁸ Part of the WAI 262 claim concerns whether the New Zealand Parliament had the right to legislate as it has done in the area of intellectual property law without proper consultation with Maori.²²⁹ As part of a response to Maori concerns in the broader intellectual property context, the New Zealand legislature promulgated a draft Trade Marks Bill that would control, and, in some circumstances, even prohibit, the use of certain Maori words and designs as trademarks.²³⁰

The New Zealand Trade Marks Bill is a domestic legislative innovation, which may provide a means of modernizing New Zealand's trademark law, while also addressing key issues of representational governance within New Zealand's unique constitutional framework. The Bill is designed with domestic circumstances in mind, and has no extraterritorial aspirations except to the extent that foreign proprietors may be precluded from securing registration of certain Maori words and symbols in the New Zealand trademark system.²³¹ Foreign proprietors' marks could be rejected on the basis that their registra-

227. See Waitangi Tribunal, *Report on Activities: Claims in Hearing*, at <http://www.knowledge-basket.co.nz/waitangi/about/inqhear.html#cl>. Amended pleadings in this proceeding were filed in October 2001.

228. Treaty of Waitangi Act, 1975, sched. 1, art. 2 available at <http://rangi.knowledge-basket.co.nz/gpacts/reprint/text/1975/sc/114sc1.html> (Oct. 10, 1975).

229. "The Crown, in breach of the Treaty of Waitangi and its principles, has implemented legislation and policy in relation to Ngati Porou flora and fauna without the permission of Ngati Porou." Statement of Claim filed by Ngati Porou, Oct. 19, 2001, para. 56.7 (on file with the author) [hereinafter Ngati Porou Statement of Claim].

230. Trade Marks Bill (N.Z.).

231. For example, in some parts of the world "ki ora" is a brand of fruit drink. In New Zealand, "kia ora" (pronounced very similarly) is one of the most common forms of greeting, meaning literally "may you be well," the Maori version of "giddyay," albeit a considerably more poetic one. Under the Bill, "ki ora" may have difficulty being registered or surviving as a trademark, notwithstanding its potential to differentiate one brand of fruit drink from another. (Currently, the website "www.kiora.com" is used by a webdesign company, which gives a Utah address on its site. Interestingly, the website acknowledges a Maori provenance for its trade name. The website includes the following: "Kia ora -interj. from Maori meaning Hello, Good Day, Thank you. Kiora is a greeting, a welcome, a thanks.")

tion is unacceptable according to a Maori advisory body charged with advising the Intellectual Property Office of New Zealand as to the cultural appropriateness of individual trademarks.²³²

It may be possible to defend such a system on the ground that the refusal to register is justified on the basis that use of a particular Maori term as a trademark would be "contrary to morality or public order," an established exception to national treatment provided for in the Paris Convention.²³³ The viability of this defense may depend on how broadly the "morality" and "public order" defenses are interpreted. In New Zealand, the concerns of Maori are not confined to registrability of marks that are themselves offensive.²³⁴ Some Maori have argued that it is not the role of the central government to be according *any* property rights in Maori symbols or words.²³⁵ The New Zealand trademark system may eventually come to impose strict controls on the registrability of a potentially large number of trademarks. It will likely be the *system* that will require justification, rather than individual decisions as to whether registration of individual marks would threaten public order or morality.

If enacted, the New Zealand trademarks legislation would provide an example of why deference to domestic experimentation in crafting intellectual property laws to suit domestic circumstances might be regarded as an important value that can usefully inform thinking about the shaping of modern international intellectual property jurisprudence. New Zealand is vigorously engaged in a decoloni-

232. The Bill enshrines in legislative form previous New Zealand trademark law practice; concerns relating to cultural sensitivity have long been taken into account in assessing the registrability of trademarks under the New Zealand Trade Marks Act 1953.

233. Paris Convention, *supra* note 11, art. 6*quinquies*.B.3. The main operative provisions of the Paris Convention are incorporated into TRIPs by art. 2.1 of the latter.

234. Cf. *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705 (T.T.A.B. 1999); Doris Estelle Long, *The Impact of Foreign Investment on Indigenous Culture: An Intellectual Property Perspective*, 23 N.C. J. INT'L L. & COM. REG. 229, (1998) (discussing various legal remedies against misappropriation of cultural artifacts).

235. See, e.g., Ngati Porou Statement of Claim. The Draft Declaration on the Rights of Indigenous Peoples includes a clause requiring restitution of intellectual property rights taken without authorization. See United Nations Econ. and Social Council, Comm'n on Human Rights, Sub-Comm'n on Prevention of Discrimination and Protection of Minorities, Draft Declaration on the Rights of Indigenous Peoples, art. 12, available at <http://www.usask.ca/native-law/ddir.html> (Aug. 1993) ("Indigenous peoples have the right to practice and revitalize their cultural traditions and customs. This includes the right to maintain, protect and develop the past, present and future manifestations of their cultures, such as archaeological and historical sites, artifacts, designs, ceremonies, technologies and visual and performing arts and literature, as well as the right to restitution of cultural, intellectual, religious and spiritual property taken without their free and informed consent or in violation of their laws, traditions and customs.").

zation agenda.²³⁶ Numerous New Zealand law reform agenda are directed at that issue,²³⁷ as New Zealand policy makers struggle to achieve sound race relations in a country scarred by the abuses of colonization and a history of race and land wars.²³⁸ The shaping of domestic intellectual property laws in ways that are sensitive to the concerns of Maori, including initiatives such as the Trade Marks Bill, has become an important issue in the decolonization agenda, an agenda that contributes significantly to domestic race relations policy.²³⁹

While the circumstances of production and consumption of intellectual property are increasingly international in character, claims may be made for individual nations to develop unique solutions for their own domestic circumstances. In this context, acknowledging the value of domestic self-determination might expand our understanding of terms such as "public order" and "morality." More profoundly, acknowledging the value of domestic experimentation might be appropriate to take into account when drafting international intellectual property instruments, so that innovations such as these do not have to be tested against concepts that accommodate them only awkwardly, if at all.

C. *Restraining Domestic Self-Interest*

But if domestic experimentation is to be valued, how might the risk that domestic self-interest will always trump the interests of

236. See generally JANE KELSEY, *A QUESTION OF HONOUR? LABOUR AND THE TREATY* (1990).

237. See generally ANDREW SHARP, *JUSTICE AND THE MAORI* (1991). A number of New Zealand statutes refer explicitly to the Treaty of Waitangi as providing fetters on the exercise of executive power. For example, the State-Owned Enterprises Act, a major piece of New Zealand law regulating the national economy, provides: "Nothing in this Act shall permit the Crown to act in a manner that is inconsistent with the principles of the Treaty of Waitangi." State-Owned Enterprises Act 1986 124 § 9, available at <http://rangi.knowledge-basket.co.nz/gpacts/public/text/1986/se/124se9.html> (Dec. 19, 1986). This section was relied on in a case involving the alienation of assets by the Crown, as a basis to prevent further alienation without consultation with Maori tribes that may have claims to the relevant land. *N.Z. Maori Council v. Attorney-General* [1987] 1 N.Z.L.R. 641 (C.A.). Claims by Maori relating to intangible rights, including intellectual property rights, are likely to be increasingly important in the decolonization agenda, given the widespread alienation of tangible assets (principally land) that has occurred since the colonization of New Zealand under the authority of the British Crown.

238. See generally JAMES BELICH, *THE NEW ZEALAND WARS AND THE VICTORIAN INTERPRETATION OF RACIAL CONFLICT* (1989).

239. See generally DAVID V. WILLIAMS, *MATAURANGA MAORI AND TAONGA: THE NATURE AND EXTENT OF TREATY RIGHTS HELD BY IWI AND HAPU IN INDIGENOUS FLORA AND FAUNA CULTURAL HERITAGE OBJECTS VALUED TRADITIONAL KNOWLEDGE* (1997) (on file with author).

foreign proprietors of intellectual property rights be avoided? To help think through these issues, it might be useful to draw, albeit loosely,²⁴⁰ on John Rawls's essay, *The Law of Peoples*,²⁴¹ in which Rawls applied in the international context the principles articulated in *A Theory of Justice*.²⁴² Rawls's methodology suggests that valuing domestic experimentation should not lead to endorsement of wholesale denial of foreigners' rights under domestic intellectual property regimes.

Behind the Rawlsian "veil of ignorance," the things an individual nation might not know when crafting its intellectual property laws might include: whether it is a net producer of intellectual property or a net consumer; whether it has a sizeable innovative community whose own survival might be jeopardized without strong intellectual property protection; whether it faces particular challenges, such as a large segment of the population that suffers from life-threatening illnesses; whether amongst its legal and social traditions there is strong support for freedom of expression; whether the nation includes an indigenous population making special constitutional or other legal claims relating either to particular substantive norms or the processes implicated in their development; whether it is already involved in regional alliances touching on intellectual property rights; and so on.

As has been noted, for many leading observers of and participants in the international intellectual property lawmaking processes, the development of standardized, globally applicable intellectual

240. Here, I draw on Rawls's discussion to identify ways that *states* can interact with one another in the international regulation and protection of intellectual property rights. Rawls, however, refers to the "Law of Peoples" throughout his analysis. *But see* Frank J. Garcia, *The Law of Peoples*, 23 Hous. J. Int'l L. 659, 666 (2001) (book review) (suggesting that Rawls's distinction between peoples and states "deflects nothing: functionally, they are identical").

241. RAWLS, *supra* note 36.

242. JOHN RAWLS, *A THEORY OF JUSTICE* (1972). For some, this may be to repeat Rawls's error of privileging states in the international law arena, as opposed to many of the other actors, such as nongovernmental organizations, who have as much independent validity as states in international relations. For a stern and compelling critique of Rawls's ideal theory in the international law context, see Lea Brilmayer, *What Use Is John Rawls' Theory of Justice to Public International Law?*, 6 INT'L LEGAL THEORY 36 (2000). Professor Brilmayer points out that "[t]here is no reason theoretically to start with states as the relevant actors" and that "[t]here are non-governmental organizations, universities, human rights organizations, churches, mosques and many other institutions that have just as much independent validity internationally as states do, from a purely theoretical point of view." *Id.* at 39. However, within the classic model of public international intellectual property law, it is states that sign on to public international law agreements, and, as we have seen, it is in the names of states that claims of breaches of these agreements are brought. This suggests that in the international intellectual property context, Rawls's methodology may assist in addressing the question of how much self-determination is tolerable.

property law norms is both inexorable and desirable. However, if we did not know about the domestic circumstances of our state, it is also possible that variations in national intellectual property laws might come to be regarded more tolerantly. If State A did not know what its domestic circumstances were to be, it may be anticipated that State A would support strong intellectual property rights, as there would be a reasonable likelihood that amongst State A's population would be innovative or creative individuals or firms as well as businesses that would be interested in protecting the goodwill they have established in trademarks and other badges of origin. State A may also be interested in attracting foreign investment.²⁴³ At the same time, it is also possible that State A might be tolerant of domestic law experimentation by other states, because this may be exactly the kind of leeway that State A itself might need in order to meet the exigencies created by its own domestic circumstances.

Adapting Rawls's analysis for the international intellectual property context may help us see that valuing domestic self-determination need not become an elaborate justification for international piracy. Normative justifications for incorporating the value of domestic self-determination need to take account of both the exigencies of domestic circumstances and the relationships between individual nations in the intellectual property context.

Detailed analysis of the ways that valuing the possibilities for domestic experimentation in intellectual property laws by individual nations might come to be reflected in international intellectual property jurisprudence must await another opportunity. The following section is proposed to offer only some initial speculations on this issue, taking into account both the value of domestic self-determination as well as limits that might be imposed on its scope.

D. The Value of Self-Determination in Forging Public and Private International Intellectual Property Doctrine

At the public international law level, an appreciation for the value of domestic self-determination might lead to an approach to the drafting of international law instruments that allow increased scope for departure from international norms, including by way of more

243. See generally Doris Estelle Long, *First, "Let's Kill All the Intellectual Property Lawyers!": Musings on the Decline and Fall of the Intellectual Property Empire*, 34 J. MARSHALL L. REV. 851, 871-73 (2001).

expansive exception clauses. In the interpretation of international law instruments, furthering the value of domestic self-determination might actually lead to less reticence about identifying policies underlying decisions to deviate from international intellectual property standards. As was noted above,²⁴⁴ in its decision on section 110(5) of the US Copyright Act, the WTO panel declined to look behind the claimed policy objectives of the home style and small business exceptions. For all that this approach has been characterized as reflecting a deferential attitude toward policies developed by individual nations,²⁴⁵ more might actually be achieved by more rigorous scrutiny of the policy objectives underlying the domestic laws that are accused of deviating too far from international norms.²⁴⁶ For instance, when applying the three-part test for scrutinizing exceptions to intellectual property rights owners' rights, it might be possible to conclude that the expectations of proprietors of intellectual property rights are not "reasonable" when they are inconsistent with domestic policies pursued as part of furthering important domestic state agenda. That is, the expectation that a proprietor of intellectual property rights derive income from exploitation in a foreign territory, an expectation that might otherwise be reasonable, may need to give way where denying the proprietor the ability to exploit the intellectual property right in a particular instance is necessary in order to achieve a compelling policy outcome.

To ensure that putative state policies do not disguise misappropriation of intellectual property rights, it may actually be appropriate for adjudicative bodies to engage in rigorous scrutiny of whether the exception to the intellectual property proprietor's right actually serves the policy that is posited as the justification. In the US section 110(5) case, for instance, the policy justification put forward by the US government for the small business exception was that the exception was necessary to foster small businesses and to prevent abusive tactics by collective copyright management organizations.²⁴⁷ The European Communities responded that the exception was too broad, given the large number of business organizations that might benefit

244. See *supra* notes 65–68 and accompanying text.

245. See generally Dinwoodie, *supra* note 32.

246. The panel expressly rejected this approach, declining to equate a "certain special case" with "special purpose." Panel Report, *supra* note 65, ¶ 6.111 (citing other WTO decisions that have declined to engage in scrutiny of the subjective policy aim behind the domestic laws or policies at issue).

247. *Id.* ¶ 6.115.

from it.²⁴⁸ However, if there were more of a willingness to engage with the policies that underlie the domestic laws that are the subject of scrutiny, it might be quite possible to challenge the small business exception based on the dubiousness of the connection between the success of small businesses and the ability to turn on a radio without acquiring a license. As an empirical matter, that connection might be quite difficult to establish.

To the extent that these suggestions are inconsistent with the WTO panel's reluctance to engage with the policies posited as the justification for the deviation from international intellectual property standards, they must be regarded as both speculative and heterodox. In the private international law context, however, there may exist greater scope for the value of domestic experimentation to influence the development of international intellectual property jurisprudence. Unlike in public international law, however, policy scrutiny of the laws under consideration is doctrinally less appropriate, outside of narrow principles associated, for example, with the doctrine of *ordre public*.²⁴⁹ One way of giving expression to the value of respect for divergent policy choices made by different nations in the shaping of their intellectual property laws is to continue the development of choice of law principles that encourage courts to ascertain and apply the laws of foreign territories in which infringements are alleged to have taken place.

To return to the Bartók example, suppose that the New Zealand Symphony Orchestra was not quite so restrained and engaged in a campaign of international marketing of the recording of the viola concerto, both within and beyond Australasia. Suppose also that one of the potential defendants was located in the United States, prompting Bartók's heir to initiate proceedings within a US forum. An approach to choice of law that would respect differences within domestic legal systems would be to apply the laws of each of the countries in which compact discs containing the new recording were marketed. Accordingly, there may be copyright infringement in countries that provide for a longer copyright term, but no infringement in countries that provide for a shorter term. Damages could be calculated, taking into account those differences.

248. *Id.* ¶ 6.116.

249. See generally Ginsburg, *supra* note 16, at 369–73 (discussing public policy exceptions to traditional choice of law rules).

In the trademarks context, valuing domestic self-determination might lead to a more deferential attitude in cases in which plaintiffs attempt to encourage US courts to apply the Lanham Act to conduct in foreign territory.²⁵⁰ For example, if a foreign country denies trademark rights to certain categories of words or symbols, it may be inappropriate for a court in another jurisdiction to apply its own trademark laws in a manner that, in effect, creates and enforces trademark rights in words or symbols that fall into that category. More generally, this approach might prompt a rethinking of the Lanham Act jurisprudence that treats the degree of conflict with foreign laws as one factor in the analysis of the propriety of the application of the Lanham Act to conduct abroad. Instead of asking whether it is appropriate to be applying US trademark law to conduct in foreign territories, it might be more useful to ask why the *foreign* trademark law, which regulates the use of signs in commerce within that territory, should not itself be applied by the US court. Such an approach brings with it a much greater likelihood that domestic policy choices regarding the regulation of signs in particular jurisdictions will have efficacy for the jurisdictions in which they were developed and where they were intended to have legal force.²⁵¹

III. THE DREYFUSS-GINSBURG DRAFT CONVENTION ON JURISDICTION AND RECOGNITION OF JUDGMENTS IN INTELLECTUAL PROPERTY MATTERS

In its basic structure, the draft *Convention on Jurisdiction and Recognition of Judgments in Intellectual Property Matters* proposed by

250. More conservatively, this approach might encourage courts to give more weight to the "degree of conflict with foreign law" factor, when analyzing the factors articulated in *Vanity Fair Mills, Inc. v. T. Eaton Co.*, 234 F.2d 633 (2d Cir. 1956). See also *Warnaco Inc. v. VF Corp.*, 844 F. Supp. 940, 950, 952 (S.D.N.Y. 1994). When applying this factor, courts have naturally been concerned with the legal significance of the *defendant's* trademark rights in foreign territories, assessing, for example, whether a pending application by the defendant is likely to succeed. See, e.g., *Les Ballets Trockadero de Monte Carlo, Inc. v. Trevino*, 945 F. Supp. 563, 567-68 (S.D.N.Y. 1996). The New Zealand Trade Marks Bill raises a different question, viz., whether a decision by a domestic legislature that certain categories of words or symbols should not be the subject of exclusive rights should prompt restraint on the part of foreign fora that are invited to apply the law of the forum to conduct involving infringement of "rights" in words or symbols that fall into the precluded categories. Thus, it may not necessarily be appropriate to conclude that merely because there is no foreign registration, "there is no evidence to support the proposition that [the foreign nation] has an interest in th[e] litigation that conflicts with application of the Lanham Act." *Libbey Glass, Inc. v. Oneida, Ltd.*, 61 F. Supp. 2d 720, 723 (N.D. Ohio 1999). I am grateful to Professor Dinwoodie for this reference.

251. See generally Bradley, *supra* note 10.

Professors Dreyfuss and Ginsburg²⁵² has the potential to support the value of self-determination in the shaping of domestic nations' intellectual property laws. This is because the Dreyfuss-Ginsburg draft avoids, for the most part, all issues of choice of law, acknowledging concerns expressed by the intellectual property practicing community that have focused on the fact that choice of law questions implicate the territorial nature of intellectual property rights.²⁵³

The jurisdiction clauses in the Dreyfuss-Ginsburg draft identify variations on the "defendants play home" rule²⁵⁴ where it might be appropriate that courts other than those of defendants' habitual residence exercise jurisdiction. In infringement actions, jurisdiction may be asserted where the defendant substantially acted in the forum (including preparatory acts),²⁵⁵ or where the forum is in any state to which the alleged infringement was intentionally directed (including states for which the defendant took no reasonable step to avoid acting in or directing activity to that State).²⁵⁶ In addition, any state in which the alleged infringement foreseeably occurred may assert jurisdiction, unless the defendant took reasonable steps to avoid acting in or directing activity to that state.²⁵⁷

The draft then imposes limitations on these bases for exercising jurisdiction. For example, where jurisdiction is taken on the ground that the forum is in a state to which the defendant directed infringing activity, the forum will have jurisdiction over only those infringements arising out of unauthorized use in that state, unless the plaintiff's habitual residence or place of business is also in the forum state.²⁵⁸ Likewise, where an action is initiated in the courts of a state only on the basis that the state is where an infringement occurred, the forum shall have jurisdiction only in respect of the injury arising out of unauthorized use that occurred in that state.²⁵⁹

252. Dreyfuss & Ginsburg, *supra* note 35.

253. *Id.* at 1066.

254. *Cf.* Brussels Convention, *supra* note 4, art. 2.

255. Dreyfuss & Ginsburg, *supra* note 35, at 1077 (art. 6.1.a).

256. *Id.* (art. 6.1.b).

257. *Id.* (art. 6.1.c).

258. *Id.* (art. 6.2) ("If an action is brought in the courts of a State only on the basis of the intentional direction of the alleged infringement to that State, then those courts shall have jurisdiction only in respect of the injury arising out of unauthorized use occurring in that State, unless the injured person has his habitual residence or principal place of business in that State.").

259. *Id.* The limitations on jurisdiction are further expanded upon in art. 16, which includes a number of prohibited grounds for exercising jurisdiction, where jurisdiction is taken "on the basis solely" of a number of factors, including the nationality of the plaintiff or defendant or the

Notwithstanding these limitations, the Dreyfuss-Ginsburg draft affords opportunities for quite expansive jurisdiction: either the defendant's forum or a forum which is both where the plaintiff is habitually resident and a place to which the defendant directed the infringing activity might have jurisdiction over all infringements. Importantly, however, the Dreyfuss-Ginsburg draft treaty does not dictate that the forum should apply *its* law to the various infringements, notwithstanding the importance of the connecting factors that establish jurisdiction.²⁶⁰ On this issue, the draft—but not the accompanying commentary—is silent.

The part of the Dreyfuss-Ginsburg proposal that does speak to choice of law is article 25, which articulates the grounds for refusal of recognition or enforcement of a judgment. Article 25.1(h) provides that recognition or enforcement of a judgment can be refused on the basis that "the rendering court's choice of law was arbitrary or unreasonable," which would include where the rendering court "applied a law lacking sufficient significant relationship to the dispute."²⁶¹ A further sentence in article 25.1(h) states: "The conformity of the forum to the jurisdictional terms of this Convention does not necessarily, of itself, suffice to establish a significant relationship between its laws and the dispute."²⁶² The latter sentence would appear to avoid the implication that application of the forum's law to all infringements will always, or necessarily, be reasonable. This may be significant: according to the Dreyfuss-Ginsburg draft treaty, before jurisdiction over infringements that occurred in a number of different foreign territories may be established, a number of fairly compelling connecting factors need to be present. In the "intentionally directing" set of cases, for instance, the forum seized of the dispute may be both the place of the plaintiff's habitual residence and at least one of the places to which the defendant's campaign of infringing activities was directed. As drafted, the Dreyfuss-Ginsburg proposal implies that the presence even of these factors will not necessarily be sufficient to avoid the risk of nonrecognition or enforcement of a judg-

seizure of tangible property in the forum state. *Id.* at 1083.

260. Nor does it expressly prohibit it. Subject to the prohibitions articulated in art. 16, the Dreyfuss-Ginsburg proposal, like the 1999 Hague Draft, provides for jurisdiction to be exercised according to the law of the forum, subject to the risk that any resulting judgment will not be enforced elsewhere.

261. Dreyfuss & Ginsburg, *supra* note 35, at 1086 (art. 25.1(h)).

262. *Id.*

ment rendered following the forum's application of its laws to all infringements, wherever they occurred.

The position becomes more complex, however, in the commentary Professors Dreyfuss and Ginsburg provide on the draft treaty. There, they identify a number of choice of law rules they regard as "[i]n general . . . presumptively reasonable."²⁶³ Some of these rules point toward application of a single governing law, such as when allegedly infringing content is found on a website: in this case, the presumptively reasonable choice of law would be the law of the country in which the operator of the website has its residence or principal place of business.²⁶⁴ If infringement is achieved other than by way of availability on a website (such as through file sharing) the governing law will be the law of the country of the person who initiated the communication.²⁶⁵ These rules would give way, however, where a third country is shown to have a "more significant relationship" with the controversy. Professors Dreyfuss and Ginsburg suggest that a country with a more significant relationship would include a third country that is the "principal target" of the defendant's infringing communication.²⁶⁶ In turn, another country may have a "more significant relationship" with a controversy, based, most likely, on further connecting factors.²⁶⁷ However, as an overarching choice of law principle in cases in which the defendant's activities are directed at a multiplicity of countries, Professors Dreyfuss and Ginsburg consider that it would be presumptively reasonable to apply the laws of *each* country to "that portion of the infringement occurring within each territory."²⁶⁸

The latter approach to choice of law can be regarded as consistent with the value of domestic self-determination, to the extent that it would appear to require courts in some instances to ascertain and apply the intellectual property laws of foreign jurisdictions. However, it is difficult to tell how strong the presumption in favor of this choice of law approach will transpire to be. It seems courts may need to work quite hard to get there, given that it is a fallback choice of law

263. *Id.* at 1145.

264. *Id.*

265. *Id.*

266. *Id.*

267. For example, a forum might be: the place where the plaintiff is habitually resident, one of the places to which the defendant's infringing activities were directed *and* the place of the defendant's habitual residence.

268. Dreyfuss & Ginsburg, *supra* note 35, at 1146.

principle that operates only after it cannot be established that a single place was the principal target of the defendant's activities, or that a particular jurisdiction has the most significant relationship to the dispute.²⁶⁹ The extent to which this choice of law principle leads to courts actually applying the laws of countries in which infringing works are consumed without authorization of the proprietor of the intellectual property rights, rather than some other law such as that of a possibly quite distant place where the defendant uploaded the work to a website,²⁷⁰ may depend on how robustly courts approach attempts to establish either a "principal target" of the infringement, or, alternatively, a place with the "most significant relationship" to the dispute (through analysis of connecting factors). Cases in which things are evenly balanced, without a gravitational pull toward any one jurisdiction, may be rare, suggesting only limited opportunities for application of foreign intellectual property laws by domestic fora.

A further concession to the possibility of domestic variation is provided for by the statement that, in fashioning remedies, the court "may take into account the extent to which, for particular countries in which acts alleged to be infringements occurred, the domestic law is substantially either more or less protective than the [chosen law]."²⁷¹ This principle might allow a court to disregard infringements in a territory in which a work is in the public domain for the purposes of calculating damages, even if the work would be protected according to the chosen law. If this principle were mandatory, rather than permissive, it might do more to support the value of domestic self-determination.²⁷²

269. *Id.* at 1145–46 ("[I]f the infringing communication was intentionally directed to a multiplicity of countries, in such a way that the country of initiation lacks a significant relationship to the dispute, but no single third country can be shown to be the principal target, or to have the most significant relationship to the dispute, then the laws of each country to which the communication was intentionally directed are applicable to that portion of the infringement occurring within each territory.").

270. *Id.*

271. *Id.* at 1146.

272. *Cf. Sheldon v. Metro-Goldwyn Pictures Corp.*, 106 F.2d 45 (2d Cir. 1939), *aff'd*, 309 U.S. 390 (1940), discussed *supra*, where the court did not determine whether there were infringements under the law of the place of unauthorized exploitation of the work. Probably as a result of Professors Dreyfuss and Ginsburg regarding this as a principle of permissive rather than a mandatory application, it was not necessary for them to clarify whether a *failure* to have regard to the level of protection afforded by the country in which a work is exploited without authorization would render the approach to choice of law "arbitrary" or "unreasonable." If, with proper deference to domestic self-determination, courts were required to consider the different levels of protection afforded by the laws of the countries of exploitation of the work, I would suggest that a failure to do so would give rise to an inappropriate choice of law, and would provide a ground for not recognizing or enforcing a judgment so rendered. In addition,

In the Internet context, however, the scope for application of this apparent concession to domestic self-determination might again transpire to be quite limited, given some of the techniques used to localize infringements in the forum. In cases such as *Primetime 24*, it was accepted that the infringements occurred in the United States, even though Canadians were the intended audience for the broadcasts. The principle articulated by Professors Dreyfuss and Ginsburg might achieve more if courts were encouraged to localize carefully all the steps in the defendant's infringing activities, recognizing that different aspects of a campaign of cross-border infringement might be localized in different territories²⁷³ and the possibility that different national laws might apply to each stage.²⁷⁴ If the issue were approached in this manner, recognizing that it is the domestic laws of the foreign jurisdictions that create the markets for the plaintiff's work, and which therefore should be applied to the infringing acts that usurp those markets,²⁷⁵ this principle might do much to further the value of domestic self-determination in the shaping of international intellectual property jurisprudence.

CONCLUSION

To scrutinize the proposal by Professors Dreyfuss and Ginsburg according to whether or not it is supportive of the value of domestic self-determination is to adopt a criterion that is only peripherally relevant to their project. While some concern for the territoriality of intellectual property rights is articulated in their proposal, their project appears to be animated more by the policy concerns of achieving a more efficient approach to transnational disputes,²⁷⁶ promoting consistent outcomes in these disputes,²⁷⁷ and preserving judicial re-

this clause as currently drafted appears to be limited to "copyright or related rights"; it may be, however, that this could be some further scope for the principle in other branches of intellectual property law, where different nations' domestic laws are "substantially either more or less protective."

273. See, e.g., *Psihoyos v. Liberation Inc.*, 42 U.S.P.Q.2d 1947 (S.D.N.Y. 1997) (reproduction of a copyright work in Austria did not implicate US copyright law, but US copyright law did apply to distribution of the infringing copies within the United States).

274. The Second Circuit has recognized that different laws might apply to different legal issues in transnational litigation. See *Itar-Tass Russian News Agency v. Russian Kurier, Inc.*, 153 F.3d 82 (2d Cir. 1998) (Russian law applied to issue of copyright ownership, whereas US law applied to infringing activity within the United States).

275. Cf. Hanns Ullrich, *TRIPS: Adequate Protection, Inadequate Trade, Adequate Competition Policy*, 4 PAC. RIM L. & POL'Y J. 153, 159 (1995).

276. Dreyfuss & Ginsburg, *supra* note 35, at 1065.

277. *Id.* at 1066.

sources.²⁷⁸ These policy concerns are of course critically important to achieving an international intellectual property jurisprudence that can meet the challenges of globalization and the continued development of technologies allowing for the international dissemination of works.

The extent to which the Dreyfuss-Ginsburg proposal supports that value of domestic self-determination is a matter of emphasis. Parts of the analysis appear to support the idea that choice of law principles can be developed in a manner that is consistent with the view that some nations may quite legitimately do some things differently, including by providing varying levels of protection for intellectual property rights. However, their analysis of the "presumptively reasonable" choices of law appear to be weighted more in favor of "single governing law" solutions, solutions that would require decision makers to engage less with possible divergences between domestic intellectual property law systems.

In the development of international intellectual property jurisprudence there may, however, be other important values at stake. One, as I have suggested in this Article, is "intellectual property self-determination": the need and ability for individual nations to do some things differently in the intellectual property sphere. Recognizing the value of domestic self-determination may usefully inform our thinking as the processes of forging intellectual property law norms for an interconnected world continue to emerge and develop.

278. *Id.*

